STIC Search Report
EIC 2800

STIC Database Tracking Number: 167383

TO: Jose Dees Location: JEF-8D59 Art Unit : 2800 Wednesday, October 05, 2005 Case Serial Number: 09/342707	From: Darcy Bates Location: EIC 2800 JEF- 4B68 Phone: 571-272-2540 darcy.bates@uspto.gov

Search Notes

Re: 09/342,707 US 5,367,588

Attached are search results.

No U. S. litigation was found in searches of Questel-Orbit databases. Please see interference 104,331 that was found in Lexis.

If more searching or explanation is needed, please let me know.

Thanks,

Darcy Bates

PALM INTRANET

Day : Wednesday
Date: 10/5/2005
Time: 11:19:03

Application Number Information

Application Number: **09/342707** **Assignments**
Filing or 371(c) Date: **06/29/1999**
Effective Date: **06/29/1999**
Application Received: **06/29/1999**
Patent Number:
Issue Date: **00/00/0000**
Date of Abandonment: **00/00/0000**
Attorney Docket Number: **312.104331R0**
Status: **90 /ALLOWED -- NOTICE OF ALLOWANCE NOT YET MAILED**
Confirmation Number: **6971**

Examiner Number: **62975 / HEALY, BRIAN**
Group Art Unit: **2874** **IFW IMAGE**
Class/Subclass: **385/037.000**
Lost Case: **NO**
Interference Number:
Unmatched Petition: **NO**
L&R Code: Secrecy Code:**1**
Third Level Review: **NO**
Oral Hearing: **NO**

Waiting for Response Desc.
MN/DR

Secrecy Order: **NO**
Status Date: **05/27/2004**

Title of Invention: **METHOD OF FABRICATING BRAGG GRATINGS USING A SILICA GLASS PHASE GRATING MASK AND MASK USED BY SAME**

Bar Code	PALM Location	Location Date	Charge to Loc	Charge to Name	Employee Name	Location
09342707ZA	28C1	06/07/2005	No Charge to Location	No Charge to Name	NGUYEN,HUY	JEF/00/A 79

Appln Info | Contents | Petition Info | Atty/Agent Info | Continuity Data | Foreign Data | Inventors | Addr

Search Another: Application# Search **or Patent#** Search
PCT / / Search **or PG PUBS #** Search
Attorney Docket # Search
Bar Code # Search

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PALM INTRANET

Day : Wednesday
Date: 10/5/2005
Time: 11:19:29

Application Number Information

Application Number: **07/969774** **Order This File Assignments**
Filing or 371(c) Date: **10/29/1992**
Effective Date: **10/29/1992**
Application Received: **10/29/1992**
Patent Number: **5367588**
Issue Date: **11/22/1994**
Date of Abandonment: **00/00/0000**
Attorney Docket Number: **140P29US**
Status: **150 /PATENTED CASE**
Confirmation Number: **5053**

Examiner Number: **62975 / HEALY, BRIAN**
Group Art Unit: **2874**
Class/Subclass: **385/037.000**
Lost Case: **NO**
Interference Number: **104331**
Unmatched Petition: **NO**
L&R Code: Secrecy Code:**1**
Third Level Review: **NO**
Oral Hearing: **NO**

Secrecy Order: **NO**
Status Date: **10/17/1994**

Title of Invention: **METHOD OF FABRICATING BRAGG GRATINGS USING A SILICA GLASS PHASE GRATING MASK AND MASK USED BY SAME**

Bar Code	PALM Location	Location Date	Charge to Loc	Charge to Name	Employee Name	Location
07969774	9200	01/18/2005	No Charge to Location	No Charge to Name	KUNG,SIV	

Appln Info | Contents | Petition Info | Atty/Agent Info | Continuity Data | Foreign Data | Inventors | Addr

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Attorney Docket # Search
Bar Code # Search

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Bates, Darcy

From: Dees, Jose
Sent: Tuesday, October 04, 2005 6:03 PM
To: STIC-EIC2800
Subject: Reissue 09/342,707.

Please do a litigation search for Patent no. 5,367,588. Reissue 09/342,707.

Thanks, J Dees

LexisNexis CourtLink

Welcome Darcy Bates!

Patent Search - Number: 5,367,588

No cases containing this patent number were found.

Return to Search

(Charges for search still apply)

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Source: Legal > Area of Law - By Topic > Patent Law > Patents > U.S. Patents > Utility Pat nts
Terms: patno=5367588 (Edit Search | Suggest Terms for My Search)

969774 (07) 5367588 November 22, 1994

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5367588

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Link to Claims Section

November 22, 1994

Method of fabricating Bragg gratings using a silica glass phase grating mask and mask used by same

REISSUE: Reissue Application filed Jun. 29, 1999 (O.G. Aug. 24,, (O.G. August 24, 1999)

INVENTOR: Hill, Kenneth O. - Kanata, Canada (CA); Malo, Bernard Y. - Gatineau, Canada (CA); Bilodeau, Francois C. - Nepean, Canada (CA); Johnson, Derwyn C. - Nepean, Canada (CA)

APPL-NO: 969774 (07)

FILED-DATE: October 29, 1992

GRANTED-DATE: November 22, 1994

ASSIGNEE-AT-ISSUE: Her Majesty the Queen in right of Canada, as represented by the Minister of Communications, Ottawa, Canada (CA), 03

ASSIGNEE-AFTER-ISSUE: October 29, 1992 - ASSIGNMENT OF ASSIGNORS INTEREST., HER MAJESTY IN RIGHT OF CANADA AS REPRESENTED BY THE MINISTER OF COMMUNICATIONS., Reel and Frame Number: 06404/0926

LEGAL-REP: Pascal & Associates

PUB-TYPE: November 22, 1994 - Utility Patent having no previously published pre-grant publication (A)

PUB-COUNTRY: United States (US)

US-MAIN-CL: 385#37

US-ADDL-CL: 264#2.6, 359#566, 359#569, 359#573, 359#900, 385#14, 385#129, 385#130, 385#147

CL: 385, 264, 359, 385

SEARCH-FLD: 385#14, 385#37, 385#129, 385#130, 385#131, 385#147, 359#558, 359#559, 359#562, 359#566, 359#569, 359#571, 359#573, 359#576, 359#900, 437#51, 430#4

IPC-MAIN-CL: 5G 02B006#34

Enter Search Terms

Terms and Connectors | Natural Language | Easy Search

patno=5367588

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Restrict by Segment:

Select a segment, enter search terms for the segment, then click Add.

Select a Segment | Add

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No Date Restrictions | From | To | Date Formats...

Search Connectors

Use connectors to show relationship between search terms. (Hover over connector for description. Click a connector to add to search.)

Syntax	Definition
and	and
or	or
w/N	within N words
not w/N	not within N words
pre /N	precedes by N words
w/p	in same paragraph
not w/p	not in same paragraph
w/seg	in same segment
not w/seg	not in same segment
w/s	in same sentence
not w/s	not in same sentence
and not	and not

View Search Comman

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Query/Command : file pluspat

Selected file: PLUSPAT

Search statement 1

Query/Command : us5367588/pn

**** SS 3: Results 1**

Search statement 4

Query/Command : prt fu legalall max

1 / 1 PLUSPAT - ©QUESTEL-ORBIT - image
PN - US5367588 A 19941122 [US5367588]
TI - (A) Method of fabricating Bragg gratings using a silica glass phase grating mask and mask used by same
PA - (A) UNITED KINGDOM GOVERNMENT (CA)
PA0 - Her Majesty the Queen in right of Canada, as represented by the Minister of Communications, Ottawa [CA]
IN - (A) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
AP - US96977492 19921029 [1992US-0969774]
PR - US96977492 19921029 [1992US-0969774]
IC - (A) G02B-006/12 G02B-006/34 H01L-031/18
EC - G02B-006/02G8M4M
G02B-006/14
G03F-007/00B3
G03F-007/20T16
PCL - ORIGINAL (O) : 385037000; CROSS-REFERENCE (X) : 264002600 359566000 359569000 359573000 359900000 385014000 385129000 385130000 385147000
DT - Corresponding document
CT - US4241109; US4806442; US4807950; US4947413; US5042897; US5042898; US5058977; US5066133; US5101297; US5104209; US5175647; US5218651; US5271024; EP0175460; EP0220652; EP0271002
STG - (A) United States patent
AB - An index grating is imprinted in the core of an optical fiber using a specially designed silica glass phase grating mask. The phase mask is held in close proximity to the optical fiber. Laser irradiation of the phase mask with ultraviolet light at normal incidence imprints (photoinduces) into the optical fiber core the interference pattern created by the phase mask.

1 / 1 LGST - ©EPO
PN - US5367588 A 19941122 [US5367588]
AP - US96977492 19921029 [1992US-0969774]
ACT - 19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: HER MAJESTY IN RIGHT OF CANADA AS REPRESENTED BY T;
EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: HILL, KENNETH O.; EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: MALO, BERNARD Y.; EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: BILODEAU, FRANCOIS C.; EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: JOHNSON, DERWYN C.; EFFECTIVE DATE: 19921026

19990824 US/RF-A
REISSUE APPLICATION FILED
EFFECTIVE DATE: 19990629
UP - 2003-22

1 / 1 *CRXX - ©CLAIMS/RRX*
AN - 2550856
PN - 5,367,588 A 19941122 [US5367588]
PA - Her Majesty Queen in right of Canada Minister of Communications CA
PT - E (Electrical)
ACT - 19990629 REISSUE REQUESTED
Issue Date of O.G.: 19990824
Reissue Request Number: 09/342707
Examination Group responsible for Reissue process: 2874

UP - 1999-33
UACT- 1999-08-24

Search statement 4

Query/Command : fam us5367588/pn

1 Patent Groups
**** SS 4: Results 6**

Search statement 5

Query/Command : famstate nonstop

1 / 6 *PLUSPAT - ©QUESTEL-ORBIT*
PN - CA2087511 A1 19940430 [CA2087511]
STG - (A1) Application laid open
TI - (A1) Method of Fabricating Bragg Gratings Using a Silica Glass

Phase Grating Mask
OTI - (A1) Procédé pour la fabrication de réseaux de Bragg à l'aide d'un masque de phase en verre de silice
PA - (A1) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IN - (A1) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IC - (A1) G02B-005/18 G02B-005/26 G03F-005/00
PN2 - CA2087511 C 20000606 [CA2087511]
STG2- (C) Patent
TI2 - (C) METHOD OF FABRICATING BRAGG GRATINGS USING A SILICA GLASS PHASE GRATING MASK
OTI2- (C) PROCEDE POUR LA FABRICATION DE RESEAUX DE BRAGG A L'AIDE D'UN MASQUE DE PHASE EN VERRE DE SILICE
PA2 - (C) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IN2 - (C) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IC2 - (C) G02B-005/18 G02B-005/26 G03F-005/00
LA - ENGLISH (ENG)
AP - CA2087511 19930118 [1993CA-2087511]
PR - US96977492 19921029 [1992US-0969774]
EC - G03F-007/20T16

1 / 1 *LEGALI - ©EPO*
PN - CA2087511 A1 19940430 [CA2087511]CA2087511 C 20000606 [CA2087511]
AP - CA2087511 19930118 [1993CA-2087511]
ACTE- 20030403 CA/EERER-A [+]
EXAMINATION REQUEST
EFFECTIVE DATE: 19960206
UP - 2004-42

2 / 6 *PLUSPAT - ©QUESTEL-ORBIT*
PN - DE4337103 A1 19940505 [DE4337103]
STG - (A1) Doc. Laid open (First publication)
OTI - (A1) Verfahren zum Herstellen von Bragg-Gittern in optischen Medien
PA - (A1) CANADA MAJESTY IN RIGHT OF (CA)
IN - (A1) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IC - (A1) G02B-001/00 G02B-005/18 G02B-006/14
PN2 - DE4337103 C2 20011213 [DE4337103]
STG2- (C2) Patent Specification (Second publication)
OTI2- (C2) Verfahren zum Herstellen von Bragg-Gittern in optischen Medien
PA2 - (C2) CANADA MAJESTY IN RIGHT OF (CA)
IN2 - (C2) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IC2 - (C2) G02B-001/00 G02B-005/18 G02B-006/34 G03F-001/08
AP - DE4337103 19931029 [1993DE-4337103]
PR - US96977492 19921029 [1992US-0969774]
EC - G02B-006/02G8M4M
G02B-006/14
G03F-007/00B3
G03F-007/20T16
DT - Corresponding document

1 / 1 *LEGALI - ©EPO*
PN - DE4337103 A1 19940505 [DE4337103]DE4337103 C2 20011213 [DE4337103]
AP - DE4337103 19931029 [1993DE-4337103]
ACTE- 19980102 DE/8110-A [+]
REQUEST FOR EXAMINATION PARAGRAPH 44

20011213 DE/D2-A [+]
GRANT AFTER EXAMINATION

20020606 DE/8364-A [+]
NO OPPOSITION DURING TERM OF OPPOSITION
UP - 2003-22

3 / 6 *PLUSPAT - ©QUESTEL-ORBIT - image*
PN - FR2697642 A1 19940506 [FR2697642]
STG - (A1) Application, first publication
OTI - (A1) Méthode de fabrication de réseaux de diffraction de Bragg.
IT - OPTICS; MANUFACTURE; GRATING; DIFFRACTION; PHASE; MASK; WAVE LENGTH; LIGHT; COLLIMATION; AMPLITUDE
PA - (A1) CANADA MAJESTY IN RIGHT OF (CA)
PA0 - HER MAJESTY IN RIGHT OF CANADA AS REPRESENTED BY THE MINISTER OF COMMUNICATIONS; P.O. BOX 11490, STATION H, OTTAWA, ONTARIO CANADA, K2H 8S2 CANADA
IN - (A1) HILL KENNETH O; BILODEAU FRANCOIS C MALO BERNA; JOHNSON DERWYN C
IC - (A1) G02B-005/18 G02B-027/42
PN2 - FR2697642 B1 19950901 [FR2697642]
STG2- (B1) Patent of invention (2nd publication)
OTI2- (B1) METHODE DE FABRICATION DE RESEAUX DE DIFFRACTION DE BRAGG.
PA2 - (B1) CANADA MAJESTY IN RIGHT OF (CA)
IN2 - (B1) HILL KENNETH O; BILODEAU FRANCOIS C MALO BERNA; JOHNSON DERWYN C
IC2 - (B1) G02B-005/18 G02B-027/42
AP - FR9313093 19931028 [1993FR-0013093]
PR - US96977492 19921029 [1992US-0969774]
EC - G02B-006/02G8M4M
G02B-006/14
G03F-007/00B3
G03F-007/20T16
DT - Corresponding document

4 / 6 *PLUSPAT - ©QUESTEL-ORBIT*
PN - GB9321774 D0 19931215 [GB9321774]
STG - (D0) Application for patent
TI - (D0) METHOD OF FABRICATING BRAGG GRANTINGS USING A SILICA GLASS PHASE GRATING MASK
PA - (D0) CANADA MAJESTY IN RIGHT OF
IN - (A) BILODEAU FRANCOIS CHARLES; HILL KENNETH OWEN; MALO BERNARD YVON; JOHNSON DERWYN CARLYLE
IC - (A) G02B-006/14 G03F-001/00
PN2 - GB2272075 A 19940504 [GB2272075]
STG2- (A) Application published
TI2 - (A) Method of making bragg gratings and grating masks therefor
PA2 - (A) CANADA MAJESTY IN RIGHT OF (CA)
IN2 - (A) BILODEAU FRANCOIS CHARLES; HILL KENNETH OWEN; MALO BERNARD YVON; JOHNSON DERWYN CARLYLE
IC2 - (A) G02B-006/14 G03F-001/00
PN3 - GB2272075 B 19960403 [GB2272075]
STG3- (B) Patent granted

TI3 - (B) Method of making Bragg gratings in optical waveguides
PA3 - (B) CANADA MAJESTY IN RIGHT OF (CA)
IN3 - (B) BILODEAU FRANCOIS CHARLES; HILL KENNETH OWEN; MALO BERNARD YVON; JOHNSON DERWYN CARLYLE
IC3 - (B) G02B-006/14 G03F-001/00
AP - GB9321774 19931022 [1993GB-0021774]
PR - US96977492 19921029 [1992US-0969774]
EC - G02B-006/02G8M4M
G02B-006/14
G03F-007/00B3
G03F-007/20T16
DT - Basic

5 / 6 PLUSPAT - ©QUESTEL-ORBIT - image
PN - JP7140311 A 19950602 [JP07140311]
STG - (A) Doc. Laid open to publ. Inspec.
TI - (A) FORMATION METHOD OF BRAGG GRATING BY USING SILICA-GLASS PHASE GRATING MASK
PA - (A) CANADA
PA0 - (A) CANADA
IN - (A) BAANAADO WAI MARO; KENIISU OO HIRU; DAAUIN SHII JIYONSON; FURANSOWA SE BIDOROO
IN0 - (A) HILL KENNETH O; MALO BERNARD Y; BILODEAU FRANCOIS C; JOHNSON DERWYN C
IC - (A) G02B-005/18 G02B-006/00 G02B-006/10 G02F-001/01
PN2 - JP2929569 B2 19990803 [JP2929569]
STG2- (B2) Grant. Pat. With A from 2500000 on
IC2 - (B2) G02B-005/18 G02B-006/10
AP - JP27036193 19931028 [1993JP-0270361]
PR - US96977492 19921029 [1992US-0969774]
EC - G03F-007/20T16

6 / 6 PLUSPAT - ©QUESTEL-ORBIT - image
PN - US5367588 A 19941122 [US5367588]
STG - (A) United States patent
TI - (A) Method of fabricating Bragg gratings using a silica glass phase grating mask and mask used by same
PA - (A) UNITED KINGDOM GOVERNMENT (CA)
PA0 - Her Majesty the Queen in right of Canada, as represented by the Minister of Communications, Ottawa [CA]
IN - (A) BILODEAU FRANCOIS C (CA); HILL KENNETH O (CA); MALO BERNARD Y (CA); JOHNSON DERWYN C (CA)
IC - (A) G02B-006/12 G02B-006/34 H01L-031/18
AP - US96977492 19921029 [1992US-0969774]
PR - US96977492 19921029 [1992US-0969774]
EC - G02B-006/02G8M4M
G02B-006/14
G03F-007/00B3
G03F-007/20T16
PCL - ORIGINAL (O) : 385037000; CROSS-REFERENCE (X) : 264002600 359566000 359569000 359573000 359900000 385014000 385129000 385130000 385147000
DT - Corresponding document

1 / 1 LEGALI - ©EPO
PN - US5367588 A 19941122 [US5367588]
AP - US96977492 19921029 [1992US-0969774]

ACTE- 19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: HER MAJESTY IN RIGHT OF CANADA AS REPRESENTED BY T;
EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: HILL, KENNETH O.; EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: MALO, BERNARD Y.; EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: BILODEAU, FRANCOIS C.; EFFECTIVE DATE: 19921026

19921029 US/AS02-A
ASSIGNMENT OF ASSIGNOR'S INTEREST
OWNER: JOHNSON, DERWYN C.; EFFECTIVE DATE: 19921026

19990824 US/RF-A
REISSUE APPLICATION FILED
EFFECTIVE DATE: 19990629
UP - 2003-22

Enter Search Terms

Terms and Connectors | Natural Language | Easy Search

5367588 or 5,367,588

Suggest Terms for My Search | Search

Check Spelling

Restrict by Segment:

Select a segment, enter search terms for the segment, then click Add.

Select a Segment | Add

Note: Segment availability differs between sources. Segments may not be applied consistently across sources.

Restrict by Date:

No Date Restrictions | From | To | Date Formats...

Search Connectors

Use connectors to show relationship between search terms. (Hover over connector for description. Click a connector to add to search.)

Syntax	Definition
and	and
or	or
w/N	within N words
not w/N	not within N words
pre /N	precedes by N words
w/p	in same paragraph
not w/p	not in same paragraph
w/seg	in same segment
not w/seg	not in same segment
w/s	in same sentence
not w/s	not in same sentence
and not	and not

View Search Comman

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*2002 Pat. App. LEXIS 330, *; 66 U.S.P.Q.2D (BNA) 1113*

DANA Z. ANDERSON, TURAN ERDOGAN, and VICTOR MIZRAHI, Junior Party (Patent No. 5,327,515), v. KENNETH O. HILL, BERNARD Y. MALO, FRANCOIS C. BILODEAU, and DERWYN C. JOHNSON, Junior Party (Patent No. **5,367,588**), v. ELIAS SNITZER, and JOHN D. PROHASKA, Senior Party (Application 08/310,426)

Patent Interference No. 104,331

Board of Patent Appeals and Interferences

2002 Pat. App. LEXIS 330; 66 U.S.P.Q.2D (BNA) 1113

August 7, 2002, Decided

CORE TERMS: mask, phase, manuscript, inventor, grating, invention, editor, volume, guest, optical, fiber, reduction, insert, patent, fax, conversation, diligence, amplitude, bragg, beam, derivation, photosensitivity, periodic, preponderance, declaration, waveguide, hearsay, diligent, failed to demonstrate, cross-examination

[*1]

Before SCHAFER, LEE, and MEDLEY, Administrative Patent Judges

COUNSEL:
For party Anderson:
Joseph M. Skerpon
BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: 202-508-9100
Fax: 202-508-9299

For party Hill:
Melvin Kraus
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Suite 1800
Arlington, VA 22209
Tel: 703-312-6600
Fax: 703-312-6666

For party Snitzer:
George E. Quillin
FOLEY & LARDNER
3000 K. Street N.W.
Suite 500
Washington, D.C. 20007
Tel: 202-672-5413
Fax: 202-672-5399

OPINIONBY: MEDLEY

OPINION:
The opinion in support of the decision being entered today is not binding precedent of the Board

MEDLEY, Administrative Patent Judge.

FINAL DECISION AND JUDGMENT UNDER 37 CFR § 1.658(a)

A. Introduction

This is a decision on priority between junior parties Anderson and Hill and senior party Snitzer. A final hearing was held 26 April 2002.

B. Findings of fact

The following findings of fact as well as those contained elsewhere in this opinion are supported by a preponderance of the evidence.

1. Anderson is involved on the basis of U.S. Patent 5,327,515, granted 5 July 1994, based on application 08/004,770, filed 14 January 1993.

2. Hill is involved on the **[*2]** basis of U.S. Patent **5,367,588,** granted 22 November 1994, based on application 07/969,774, filed 29 October 1992.

3. Snitzer is involved on the basis of U.S. application 08/310,426, filed 22 September 1994.

4. Snitzer has been accorded benefit for the purpose of priority of U.S. application 07/963,839, filed 20 October 1992 n1.

n1 Snitzer's involved application is a straight continuation of the 07/963,839 application.

5. The interfering subject matter pertains to a method for fabricating Bragg gratings in an optical waveguide by disposing a phase grating mask adjacent and parallel to the optical waveguide and applying a single collimating light beam through the phase grating mask.

6. Count 2 n2, the sole count of the interference is as follows:

> A method of fabricating a Bragg grating in the interior of an optical waveguide comprising disposing a phase grating mask adjacent and parallel to a photosensitive optical waveguide and applying a single collimating light beam through the mask to said waveguide.

n2 Count 2 was substituted for the original count 1. (Paper 209).

7. The claims of the parties are:

Anderson:	1-8
Hill:	1-24
Snitzer:	11-23 and 25-39

8. The claims **[*3]** of the parties that are designated as corresponding to Count 2 n3 are:

Anderson:	1, 2 and 5-8
Hill:	1, 5-11 and 17-23
Snitzer:	11-23 and 25-39

n3 See Paper 209.

9. The claims of the parties that are designated as not corresponding to Count 2 n4 are:

Anderson:	3 and 4
Hill:	2-4, 12-16 and 24
Snitzer:	none

n4 See Paper 209.

The invention and the meaning of "phase grating mask"

10. In our decision on preliminary motions, we made a finding that "phase mask" or, "phase grating mask" n5 as recited in the count, is a transparent mask having varying thickness across the surface of the mask (Paper 208 at 17).

n5 We use the term "phase mask" and "phase grating mask" interchangeably, as do the parties in their respective briefs.

11. Specifically as we discussed in that decision, Shirasaki n6 shows in Fig. 6 a phase grating mask as shown below.

n6 Shirasaki et al. (Shirasaki), U.S. Patent 4,806,422, granted February 21, 1989, based on application 06/841,801, filed March 20, 1986.

[SEE Fig. 6 IN ORIGINAL]

12. The description of Shirasaki Fig. 6 is as follows:

> The illustrated mask is in the form of plate 11 which consists of a material transparent **[*4]** to the exposure radiations such as quartz glass, the plate having selectively formed on a major surface thereof rectangular parallelopiped-shaped projections 24 which also consist of a material transparent to the exposure radiations such as silicon dioxide (SiO[2]). (Shirasaki, column 9, lines 59-65).

13. Brooks n7 states the following with respect to phase masks, distinguishing phase masks from amplitude masks:

> The diffracted light beam 35 eventually impinges on an opaque filter 38. This may, for example, be an opaque plate such as a metallic plate having a suitable pattern cut out. Such a plate may form an amplitude mask which masks the diffracted light beam in accordance with its amplitude. Alternatively a phase mask may be used, this may, for example, consist of glass plate having a varying thickness so as to delay the wave front by different amounts depending on the thickness of the glass. (Column 3, lines 59-65).

n7 Brooks et al. (Brooks), U.S. Patent 3,668,405, granted 6 June 1972, based on application 04/791,597, filed 16 June 1969. This reference was not relied upon during the prosecution of the involved Hill or Anderson patents or the Snitzer involved application. **[*5]**

14. In the involved Hill patent the "phase grating mask" is shown as a transparent mask, for example, in Fig. 1a with a surface relief pattern 5 approximating a square-wave as shown.

[SEE FIG. 1a IN ORIGINAL]

15. In the involved Anderson patent the "phase grating mask" is shown as a transparent mask, for example, in Fig. 2 with a surface relief pattern 40 approximating a square-wave as shown.

[SEE FIG. 2 IN ORIGINAL]

16. The involved Snitzer application describes the invention as follows:

> It has been discovered that by passing light from a source of the actuation frequency through a mask with periodic variation in transmission, phase, or other optical property a diffraction pattern is formed that can be used to produce a periodic variation in index along the core of an optical waveguide fiber, and thus a Bragg grating. (Snitzer 08/310,426 application, at 1).

17. Thus, the parties were on notice as to our finding of the count term "phase grating mask."

18. None of the parties involved in this interference objected to that finding.

Anderson's Brief on Priority

19. Anderson alleges a date of conception before 2 July 1992 (Paper 274 at 59).

20. Anderson alleges a date of actual **[*6]** reduction to practice of the method of the count on 9 January 1993 (Paper 274 at 63).

21. Anderson alleges acts of diligence toward actually reducing the method of the count to practice, from prior to Hill's 8 September 1992 alleged date of conception until Anderson's alleged date of actual reduction to practice (Paper 274 at 64).

22. Anderson's preliminary statement states that Dana Z. Anderson (Dr. Anderson) and Victor Mizrahi (Dr. Mizrahi) conceived of the invention of the count (Paper 101).

Conception

23. Dr. Anderson was a visiting consultant at AT&T Bell Laboratories in early April 1992 (AR 290, P3).

24. There, he became acquainted with Dr. Mizrahi's procedures for growing Bragg gratings in photosensitive optical fibers using an interferometer (AR 291, P4).

25. On April 6, 1992 Dr. Anderson thought of an idea for improving upon the stability of the interferometer by using a fused silica substrate plate with polymer coating to act as a beamsplitter for recombining the original UV beams (AR 291, P5).

26. According to Dr. Anderson, he had the idea that the beamsplitting plate would also serve as a phase grating mask for growing Bragg gratings, by (i) placing the mask adjacent **[*7]** and parallel to a photosensitive optical fiber and (ii) applying a single collimated ultraviolet laser beam through the phase mask (AR 291, P6).

27. Dr. Anderson communicated this idea to Dr. Mizrahi (AR 291, P7).

28. Anderson alleges that the idea was communicated to Alice E. White (Dr. White), a noninventor.

29. Dr. White was the department head overseeing the group that performed research and development in the field of optical fiber devices, of which Dr. Mizrahi was a part.

30. Dr. White was responsible for hiring Dr. Anderson as a consultant.

31. Dr. White recalls that either Dr. Anderson and/or Dr. Mizrahi communicated to her their idea for the method of the count, no later than May 7, 1992.

32. Dr. White recalls the Anderson inventors conveying to her the idea of placing a phase mask adjacent and parallel to a fiber and applying a single beam of light through the phase mask onto the fiber (AR 295, P5).

33. Dr. White recalls the event based on a memorandum she prepared, dated May 7, 1992.

34. The memorandum states that "from previous discussions we know Dana [Anderson] to be a fertile source of bold new ideas that have implications, for instance, for the high volume manufacturing **[*8]** of fiber phase gratings" (Anderson Ex. 1027).

35. Dr. White states that her reference to "bold new ideas" was with the thoughts of the method of the count conceived of by Drs. Anderson and Mizrahi (AR 296, P7).

36. The memorandum was prepared for signature by Alastair M. Glass (Dr. Glass) (Anderson Ex. 1027).

37. Dr. Glass states that he too recalls that the "bold new ideas" referred to in the memorandum involved placing a phase mask adjacent and parallel to a photosensitive optical fiber and applying a single beam of light through the phase mask onto the fiber to make a Bragg grating in the fiber (AR 304, P6).

38. On 2 July 1992, Dr. White made an entry in her notebook that states:
"Ti - mask - commercially available
- interested in getting phase
mask that can be
placed next to fiber
have second order, want
first order" (Anderson

Ex. 1030).

39. Anderson relies on the entry as further evidence of corroboration of the alleged conception (Paper 274 at 59).

40. Dr. White states that she suggested using an ion-implementation method to make a phase mask, and that her notebook entries indicate this (AR 298, P13).

Acts of diligence

41. Dr. Anderson left Bell **[*9]** Labs in April 1992 and did not return until January 1993.

42. Dr. Anderson states that when he returned to the University of Colorado, he was unable to pursue the fabrication of a phase mask because he lacked the equipment and knew of no person there who could make a phase mask (AR 292, P10-11).

43. Dr. Erdogan states that during most of 1992, his laboratory did not have a phase mask suitable for making Bragg gratings in optical fibers (AR 284-285, P17).

44. Dr. Erdogan further states that he and Dr. Mizrahi researched several methods for making a phase mask.

45. Anderson directs us to the following activities regarding Drs. Mizrahi and Erdogan's research for making a phase mask (Paper at 72, Table 2):

a) on **19 November 1992,** Dr. Mizrahi modified his optical system to accept substrates coated with material suggested by Tim Weidman and exposed the coated substrates (AR 273, P30).

b) on **20 November 1992** and on **23 November 1992,** Dr. Mizrahi exposed planar substrates in an attempt to make a phase mask (AR 273-274, PP31-32).

c) on **21 December 1992,** Dr. Erdogan attempted to make a phase mask by patterning a chromium film that was deposited on a silica substrate and **[*10]** impinging a pattern of laser light on the film (AR 285-286, P19).

d) on **7 January 1993,** Dr. Erdogan used a two beam interferometer to write gratings in samples of Tim Weidman's photodefinable material to make a phase mask (AR 285, P18).

e) "in **late December 1992 or early January 1993"** Dr. Erdogan states that his lab acquired a chromium-on-silica amplitude mask. The amplitude mask was converted to a phase mask by reactive-ion etching followed by stripping of the chromium (AR 286, P20). (This phase mask was ultimately the one used to reduce the invention to practice) (AR 286-287, P22).

f) on **8 January 1993,** Dr. Erdogan performed diffraction measurements to characterize the converted mask (AR 286, P21).

g) on **7 January 1993 and 8 January 1993,** Dr. Mizrahi made trial exposures of Tim Weidman's photodefinable material for the purpose of making a phase mask (AR 275, PP40 and 41).

Hill's conception

46. Hill alleges an 8 September 1992 date of conception (Paper 272 at 28).

47. Kenneth O. Hill (Dr. Hill), one of the Hill inventors, testified that he, along with B. Malo, F. Bilodeau and D.C. Johnson co-authored "Photosensitivity in Optical Fibers" (Hill manuscript) **[*11]** for Volume 23 of the Annual Review of Materials Science, which he alleges describes the elements of the count (HR 12, PP21-22).

48. The Hill manuscript describes the method of the count (HR 52-53 and 88).

49. To establish the 8 September 1992 date, Hill relies on a receipt received by it from Sandra Cooperman (Cooperman) indicating that the Hill manuscript had been received by the Annual Review Office.

50. The receipt has a date stamped SEP 08 1992, with the words "We acknowledge with thanks the receipt of your manuscript for the Annual Review of MATERIALS SCIENCE".

51. The receipt is signed "Sincerely yours, ANNUAL REVIEWS INC., Sandra Cooperman (Production Editor)".

52. Cooperman has been the Production Editor for the Annual Review of Materials Science (Annual Review) since prior to May 1992.

53. As Production Editor, Cooperman is responsible for organizing and orchestrating an entire series, or volume for the Annual Review (HR 230, line 16 to HR 231, line 7).

54. As further evidence of its date of conception, Hill has submitted into evidence a marked-up copy of the Hill manuscript with SEP 08 1992 stamped on the front page (HR 93).

55. Cooperman testified that when a manuscript **[*12]** arrived at the Annual Review Office, the manuscript was stamped with the day it was received on the front page of the manuscript (HR 270, lines 2-23).

Actual Reduction to Practice

56. Hill relies on its manuscript as an actual reduction to practice (Paper 272 at 31).

57. Specifically, Hill relies on the description in its manuscript of testing it did to meet the limitations of the count.

Diligence

58. Hill alternatively argues that it reduced to practice its invention by 29 October 1992, when Hill's involved application was filed (Paper 272 at 42).

59. Hill seeks to establish diligence from its 8 September 1992 conception to its constructive reduction to practice (Paper 272 at 42).

60. Hill relies on a letter dated 14 September 1992, requesting Mr. Ed. Pascal to provide a cost estimate for filing a patent application (HR 156).

61. Attached to the letter is a description of the Hill invention (HR 158).

Hill's case of derivation

62. Hill argues that Snitzer derived the invention from it (Paper 311 at 49).

63. Hill alleges that inventor Elias Snitzer received and read a copy of the Hill manuscript sometime after 8 September 1992, but prior to 17 October 1992, when the Snitzer **[*13]** inventors amended their parent

'839 application to include use of a phase mask.

64. Elias Snitzer was a guest editor for Volume 23 of the Annual Review of Materials Science.

65. In early April 1992, Dr. Snitzer invited Dr. Hill to write a review for Volume 23 (SR 1032, lines 2-14 and 1033, lines 4-10).

66. Hill alleges that it sent a facsimile to Dr. Snitzer on 24 April 1992, with an outline of the manuscript Hill was to write for Volume 23 (HR 6-7).

67. The facsimile is addressed to "Prof E. Snitzer" at Rutgers University (HR 18).

68. Hill relies on the fax as an indication that Dr. Snitzer was interested in Dr. Hill's article (Paper 272 at 50).

69. Hill does not apparently rely on the fax to demonstrate that the actual contents of the fax were received by Dr. Snitzer, or that the actual content of the fax contains a written description of Hill's conception (Paper 294 at 39).

70. Dr. Hill testified that Cooperman sent him a letter dated 24 April 1992 (HR 23) n8 confirming that Dr. Hill had agreed to write an article for the review (HR 9, P15).

n8 Snitzer moves to exclude the letter. For reasons given infra at 55, the letter is excluded. However, not excluded is Hill's testimony that he received the letter from Cooperman. **[*14]**

71. Dr. Hill alleges that Dr. Snitzer had requested that a copy of the Hill manuscript be sent directly to him (HR 10).

72. Dr. Hill testified that Cooperman sent him a letter dated 12 May 1992 (HR 24) n9, advising Dr. Hill to send the manuscript to the Office of the Annual Review of Materials Science and not to the guest editors as they had initially requested (HR 9, P16).

n9 Snitzer moves to exclude the letter. For reasons given infra at 57, the letter is excluded.

73. The letter states that:

> I am aware that Dr. Laudise or Dr. Snitzer asked that the manuscript be sent to them directly but because all production and editing emanates from this office, I request that you send your manuscript here. Please send two copies and I will forward one immediately to the senior editors. (HR 24).

74. Hill's manuscript was received by the Annual Review of Materials Science on 8 September 1992 (Findings 49 and 54).

75. Cooperman testified that the following procedures were followed in connection with the submission of manuscripts for Volume 23 of the Annual Review of Materials Science:

a) the guest editors for the Volume 23 were Robert A. Laudise and Elias Snitzer, whose **[*15]** responsibility was to find the best qualified authors to write on the keynote topic;

b) after the authors produced their manuscripts on the keynote topic, the manuscript was sent to the offices of the Annual Review of Materials Science;

c) when the manuscript arrived at the Annual Review of Materials Science, it was immediately sent to all of the guest editor(s) to be read;

d) after the manuscript was received by the office, a receipt for the manuscript was sent to the authors;

e) the manuscript was copy-edited in-house and sent to the editor or one of the associate editors for review;

f) the authors then received the manuscript to make comments, ask questions, etc. (HR 214-216).

76. During cross-examination, Cooperman again testified that for Volume 23 a copy of each manuscript for the keynote topic n10 was sent to each guest editor (HR 265, lines 9-10; HR 271, lines 15-17).

n10 There is no dispute that the Hill manuscript was for a keynote topic.

77. Although Cooperman testified affirmatively that she would have only sent copies of the manuscript to Dr. Laudise, if he had so requested, she also testified that she did not think that she sent the Hill manuscript only to **[*16]** Dr. Laudise and not to Dr. Snitzer (HR 277, lines 1-23).

78. A fax dated "3/3/93" was sent to Cooperman with an insert "A" made by Dr. Snitzer which is part of the introduction to Volume 23 of the Annual Review of Materials Science (Snitzer Ex. 3035).

79. Hill argues that from the content of the insert, it is clear that Dr. Snitzer read the Hill manuscript (Paper 311 at 59).

80. Hill submits a comparison of the introduction to Volume 23 with the introduction to Hill's manuscript (Hill Ex. 1058).

81. The comparison shows similarities between the two introductions.

82. Although the insert prepared by Dr. Snitzer does not describe the elements of the count, it does describe generally the concept of writing gratings in optical fibers.

83. Cooperman testified that when a guest editor wrote an introduction that they would know what had been written:

Q And I think we saw in Volume 23 that there was an introduction run by the guest editor.

A That's correct.

Q That's something they can do also.

A Yes.

Q And sometimes guest editors read manuscripts.

A I'm sorry.

Q Sometimes guest editors read manuscripts.

A The guest editors receive copies of all of the manuscripts for the keynote topic **[*17]** simply to read.

Q They are not asked to do the editing that the --

A No, no. The point being that when they wrote the introduction, they would know what had been written; and if they wanted to talk about a specific manuscript, they could. (HR 265, lines 1-14).

84. Snitzer testified that he received two manuscripts from Dr. Laudise, one by Mahmoud Abouelleil, "Ion Exchange in Glasses and Crystals" and the Nicolaas Bloembergen article (SR 1037, lines 11-22).

85. Hill argues that these two manuscripts could not have been the basis for the description made in the insert "A" by Dr. Snitzer (Paper 311 at 61).

86. Dr. Snitzer testified that he had no recollection of receiving the Hill manuscript (Snitzer Ex. 3005).

87. Dr. Snitzer testified that he did not read the Hill manuscript at any time during the pendency of his '839 application, which issued 27 September 1994 (Snitzer Ex. 3005).

88. Dr. Snitzer testified that he never reviewed the Hill manuscript prior to the filing of the Snitzer '839 application (SR 418, P45).

89. Dr. Snitzer testified that he never received any manuscripts from Sandra Cooperman (SR 419, P48).

90. Dr. Snitzer testified that he was busy and that his contributions **[*18]** as guest editor were only to find authors to write articles (SR 417, P38).

91. He further testified that the late Dr. Laudise, the other guest editor, performed most of the guest editing work (SR 417, P39).

92. Dr. Snitzer further testified that he sent all pertinent information regarding his application to his patent agent Dr. Stubbs and that he did not send Dr. Stubbs a copy of the Hill manuscript (SR 419, P46).

93. Dr. Snitzer also testified that he checked his files and did not find a copy of the Hill manuscript (SR 419, P47).

94. Snitzer further testified that he was not very good at keeping files (SR 972, lines 1-4 and SR 992, lines 19-20).

95. Mr. Wachtman, one of the associate editors for Volume 23, testified that Dr. Snitzer was busy and that it was his impression that Dr. Snitzer took direction from Dr. Laudise, who took a strong interest in the Volume 23 (SR 284).

Snitzer's case of conception

96. Snitzer relies on the oral testimony of the Snitzer inventors to demonstrate that they conceived of the method of the count on 21 July 1992 (Paper 278 at 39).

97. Specifically, Drs. Snitzer and Prohaska testified that they conceived of disposing a periodic object mask, which **[*19]** included using phase masks or amplitude masks, adjacent and parallel to a photosensitive optical waveguide and applying a single collimating light beam through the mask to the fiber (SR 408, P9; 459, P13).

98. Snitzer relies on the testimonies of Dr. Rishton and Dr. Stubbs, an Invention Questionnaire, and the oral testimony of inventor Dr. Prohaska to corroborate a date of conception by the end of July 1992 (Paper 278 at 40).

99. Snitzer argues that the Invention Questionnaire, entitled "Mask Fabrication of Photo Refractive Gratings" describes every element of the count with the exception of a "phase grating mask" (Paper 278 at 41).

100. The Questionnaire refers only to a periodic object mask (Snitzer Ex. 3032).

101. Illustrations and examples of the "periodic object mask" are illustrated as an amplitude mask only (Paper 278 at 44).

102. In July 1992, the Snitzer inventors contacted Dr. Rishton about obtaining a grating mask that the inventors could use in experiments for forming Bragg gratings.

103. In his declaration, Dr. Rishton stated that on 22 July 1992, he spoke with Dr. Snitzer about obtaining a grating mask (SR 470, P8).

104. Rishton recalls Dr. Snitzer mentioning, during **[*20]** the 22 July 1992 conversation, both amplitude and phase masks and that Snitzer and Rishton discussed the possibilities of fabricating both (SR 470-471, P9).

105. Rishton recalls a conversation he had with Dr. Prohaska within a few days of speaking with Dr. Snitzer, in which the two discussed the type of mask to be fabricated.

106. According to Rishton, Dr. Prohaska indicated that either a phase mask or an intensity mask would work in their Bragg grating project (SR 471, P11).

107. Per the conversation, it was determined that Dr. Rishton would manufacture an intensity mask (amplitude mask), since he could do so more quickly (SR 472, P12).

108. Dr. Rishton was subsequently asked, e.g. after the alleged conception date, to make a phase mask and did so in 1993 (SR 801-802).

109. Dr. Rishton maintained meeting records and lab records regarding the July 1992 conversations he had with the Snitzer inventors (Snitzer Ex. 3039 and 3040).

110. The records do not use the term phase grating mask (phase mask) or otherwise describe a phase grating mask.

111. At one point during cross examination, Dr. Rishton could not recall the term phase mask being discussed during his meeting with either Dr. **[*21]** Snitzer or Dr. Prohaska in late July 1992.

Specifically, Dr. Rishton testified as follows:

Q Okay. You're - referring to Exhibit 3039. At the top of the page you have identified Rutgers grating masks?

A Yes.

Q Was that the term that you recall Dr. Snitzer using during you discussion?

A It was the term I used. I'm not sure if it was the term he used.

Q Do you recall his using any other terms?

A I don't recall it at this point.

Q So to the best of your knowledge no other terms were used by Dr. Snitzer or Dr. Prohaska at that time

other than grating masks?

A Not to my memory. (SR 782, lines 7-20).

112. Later, in his cross-examination testimony, Dr. Rishton recalled the term phase mask being discussed with Dr. Prohaska and Dr. Snitzer. (SR 798-799, lines 24-15).

113. Dr. Rishton could not recall if he had ever met Drs. Snitzer or Prohaska in person (SR 754, lines 13-25).

114. Rishton could not recall if he had ever made a mask prior or subsequent to making one for the Snitzer inventors (SR 757, lines 6-15).

115. Rishton could not recall whether he or Dr. Snitzer initiated the phone conversation to discuss making a mask for the Snitzer inventors (SR 771, lines 8-24)

116. Dr. Rishton also **[*22]** did not recall whether he made a presentation at a conference he attended just two months prior to his phone conversation with Dr. Snitzer or Dr. Prohaska (SR 776, lines 2-11).

117. Dr. Prohaska testified that he performed calculations based on using a phase mask for the Snitzer project within about one or two weeks of his discussion with Dr. Snitzer on 21 July 1992 (SR 464, P31).

118. Dr. Rishton testified that in the initial discussion with Dr. Snitzer (22 July 1992), that Dr. Snitzer "told me that a phase structure would be better for those for patterning according to their calculations . . ." (SR 824, lines 17-19).

119. The calculations that Prohaska did, however, were performed after Dr. Rishton's and Dr. Snitzer's initial conversation.

120. Dr. Stubbs, the Snitzer inventor's patent agent, testified that based on a meeting he had with Dr. Snitzer on 30 July 1992, he believed that a mask having any form of periodic variation in optical properties was within the invention, whether they affected phase or amplitude of the transmitted light (SR 487, P11).

121. Stubbs, during his cross-examination, testified that he could not recall the discussions he had with Dr. Snitzer during the **[*23]** 30 July 1992 meeting (SR 878, lines 5-13).

122. Stubbs does not recall the term phase mask ever being used during the conversations he had with the Snitzer inventors for writing their '839 application (SR 896-897, lines 19-14).

123. Stubbs does not recall a telephone conversation with Dr. Prohaska in which Dr. Prohaska allegedly emphasized that a phase mask embodiment should be included in the '839 application (SR 899, lines 10-16).

Snitzer's motion to suppress

124. Snitzer has filed a miscellaneous motion to suppress the following of Hill's evidence:

a) Hill Ex. 2008 - U.S. patent 5,104,209 - a patent issued to the Hill inventors;

b) Hill Ex. 2016 (paragraphs 3 and 4) of 25 June 1999 Declaration of Sandra H. Cooperman;

c) Attachment I to Hill Ex. 2016 - duplicate copy of letter from Sandra Cooperman to Kenneth O. Hill (dated 24 April 1992);

d) Attachment II to Hill Ex. 2016 - duplicate copy of receipt from the Annual Review of Materials Science (dated 8 September 1992);

e) Hill Ex. 2030 - draft of Prohaska thesis;

f) Hill Ex. 2044 - a facsimile from Kenneth Hill to E. Snitzer (dated 24 April 1992);

g) portions of Hill Ex. 2045 - First declaration of Kenneth O. **[*24]** Hill;

h) Attachment I to Hill Ex. 2045 - duplicate copy of Snitzer fax;

i) Attachment II to Hill Ex. 2045 - duplicate copy of Cooperman 24 April 1992 letter;

j) Attachment III to Hill Ex. 2045 - letter from Sandra Cooperman to Authors of Volume 23 of the Annual Review of Materials Science (dated 12 May 1992);

k) Attachment IV to Hill Ex. 2045 - original manuscript of Kenneth Hill's article for Volume 23 of the Annual Review of Materials Science;

l) Attachment V to Hill Ex. 2045 - duplicate copy of the Annual Review Receipt;
m) Attachment VI to Hill Ex. 2045 - Hill's edited manuscript;

n) Attachment VII to Hill Ex. 2045 - letter from Sandra Cooperman to K.O. Hill (dated 19 March 1999);

o) portions of Hill Ex. 2046 - the second declaration of Kenneth O. Hill (dated 23 April 2001);

p) Attachment I to Hill Ex. 2046 - letter from Zaki Muscati to Edward Pascal (dated 14 September 1992);

q) Attachment II to Hill Ex. 2046 - report of an invention submitted by Hill (dated 10 September 1992);

r) Hill Ex. 2057 - Publication & Press Guidelines from a Gordon Conference;

s) Hill Ex. 2058 - comparison of Hill manuscript with the portion of the introduction for Volume 23 that **[*25]** was written by Elias Snitzer;

t) Hill Ex. 2059 - article by Mahmoud M. Abouelleil from Volume 23 of the Annual Review of Materials Science;

u) Anderson Ex. 1024 - copy of articles entitled "Magnification of Mask Fabricated Fibre Bragg Gratings" by J.D. Prohaska, E. Snitzer, S Rishton and V. Boegli from Vol. 29, No. 18 of Electronics Letters (2 September 1993).

C. Discussion

Anderson's Case on Priority

Anderson, as the most junior party in this interference, has the burden of establishing priority with respect to both Hill and Snitzer by a preponderance of the evidence. 37 CFR § 1.657(b).

Priority of invention belongs to the first party to reduce the invention to practice unless the other party can establish that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing the invention to practice. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000). Here, Anderson alleges an actual reduction to practice date of 9 January 1993. That date, however,

is still subsequent to both Hill's and Snitzer's effective filing dates.

Anderson may prevail if Anderson can establish **[*26]** that it was the first to conceive the invention and that it exercised reasonable diligence from a time prior to Hill's and Snitzer's conception until its own reduction to practice. 35 U.S.C. § 102(g); 204 F.3d at 1097, 53 USPQ2d at 1698. Anderson seeks to establish that it conceived prior to Hill's 8 September 1992 alleged date of conception n11 and that Anderson was reasonably diligent from a time prior to 8 September 1992 until Anderson's actual reduction to practice date of 9 January 1993.

n11 Although Snitzer alleges a prior date of conception of July 22, 1992, Anderson in its brief argues that Snitzer has failed to prove that date of conception. For the reasons discussed infra, we agree that Snitzer has failed to demonstrate a date of conception prior to 17 October 1992. Thus, Anderson must demonstrate that it was diligent from just prior to 8 September 1992 until 9 January 1993.

Snitzer argues that Anderson has failed to prove conception by a preponderance of the evidence. Because Anderson has failed to sufficiently demonstrate that it was diligent in reducing its invention to practice, we **[*27]** have not and need not consider Snitzer's arguments regarding conception. For purposes of this discussion, we assume that Anderson has demonstrated an April 1992 date of conception.

Diligence

Anderson alleges acts of diligence from a time prior to 8 September 1992, until its actual reduction to practice date of 9 January 1993, e.g. the "critical period." To satisfy the reasonable diligence requirement, the work relied on must ordinarily be directly related to reduction to practice of the invention of the count at issue. Naber v. Cricchi, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977).

Dr. Anderson was in Colorado working as a university professor from September 1992 until the beginning of January 1993 (Finding 41). Thus, Anderson relies on the activities of Dr. Mizrahi and Dr. Erdogan for demonstrating reasonable diligence for the "critical period" (Paper 274 at 69-78).

Anderson argues that Drs. Erdogan and Mizrahi performed activities that were directly relevant to reducing the method of the count to practice (Paper 274 at 69). Those activities have been characterized by Anderson as follows: 1) work to obtain a phase mask, 2) studies **[*28]** of optical fiber photosensitivity and studies of grating growth, 3) work to optimize optical beams of grating growing equipment, and 4) work to maintain the same equipment (Paper 274 at 70).

The evidence in support of the activities that Anderson directs us to, does not support Anderson's argument that the activities were directly related to reducing the count to practice. First, Anderson has failed to direct us to evidence that demonstrates that it was diligent in its activities to obtain or make a phase mask prior to 19 November 1992.

Anderson argues that a phase mask was not available to the inventors at the start of the critical period, citing to the declaration of Dr. Erdogan (Paper 274 at 71). Dr. Erdogan testified that his lab did not have a phase mask suitable for making bragg gratings (Finding 43). From this, we do not know what, if any, efforts were made to try to find a phase mask, or what attempts were made to make a phase mask. All we know is that Erdogan's lab did not have a phase mask.

Dr. Erdogan further states that he and Dr. Mizrahi researched several methods for making a phase mask. No dates or specific activities are given in connection to this statement. The only **[*29]** specific activities that Anderson directs us to regarding the making of a phase mask occurred from 19 November 1992 until 9 January 1992 (Paper 274 at 72). This does not explain what, if anything, the inventors were doing to obtain or make a phase mask prior to 19 November 1992 n12.

n12 During oral argument, counsel for Anderson acknowledged that there were no activities by the inventors of obtaining a phase mask or making a phase mask prior to 19 November 1992. (Transcript at 9-10, lines 19-8).

From 8 September 1992 until 19 November 1992, there are approximately nine weeks during which time there are no specific activities towards obtaining a phase mask or making a phase mask. That Anderson failed to diligently seek to obtain or make a phase mask until well after the 8 September 1992 critical date is fatal to Anderson.

The count of this interference involves a method for fabricating a Bragg grating in the interior of an optical waveguide by: 1) disposing a phase grating mask adjacent and parallel to the optical waveguide and, 2) applying a single collimating light beam through the mask to the optical waveguide (Finding 6). Although the count requires essentially performing two **[*30]** steps with two elements, e.g. a phase mask and a single collimating light beam, Anderson fails to show activities of obtaining either a phase mask or experimenting with a single light beam n13 until well after the beginning of the critical period.

n13 During oral argument, counsel for Anderson indicated that the Anderson inventors did not use a single collimating light beam until the inventors obtained a phase mask (Paper 324 at 20, lines 11-17).

In this light, Anderson takes the position that there were other related activities that the inventors did towards reducing the invention to practice, that occurred prior to 19 November 1992, e.g. the first attempt to obtain/make a phase mask, and after that time.

Those activities that Anderson argues are directly related to reducing the invention of the count prior to the end of November 1992 are directed to activities that apply generally to studying and experimenting with various ways to form Bragg gratings. Anderson has failed to direct us to sufficient evidence that would demonstrate that the other activities are directly related or precursors to reducing the invention to practice.

For example, Anderson argues that Drs. Erdogan and **[*31]** Mizrahi worked on studying photosensitivities and grating growth rates since they did not have a phase mask or knew they would only be able to obtain an inferior phase mask. Anderson argues that:

> The studies of optical fiber photosensitivities were also proper diligence activity, because the studies identified fibers with high photosensitivity. The identification of fibers with high photosensitivities was relevant to reduction to practice of the count, because, Drs. Mizrahi and Erdogan, were unsuccessful at obtaining a phase mask suitable for practicing the count prior to January 8, 1993. Anderson Exh. 1031, pars. 31, Record pp. 0273-0274; Anderson Exh. 1032, pars. 18-19, pp. 0285-0286; Anderson Exh. 1034, pars. 19-21, Record p. 0299-300. The inventors believed that they might have to use a phase mask of low quality to reduce-to-practice the count. Anderson Exh. 1032, par. 9, Record p. 0280-0281; Anderson Exh. 1049, Record p.0821, line 18, to Record p. 0823, line 19. Of course, they could not be sure of the mask quality prior to a successful production of a phase mask. Furthermore, the inventors knew that low mask quality would interfere with successfully reducing-to-practice **[*32]** the count, if the optical fiber being written was not sufficiently photosensitive. Anderson Exh. 1032, par. 9, Record pp. 0280; Anderson Exh. 1049, Record p. 0822, line 1, to p. 0823, line 9. Thus, the inventors knew that a fiber with high photosensitivity could compensate for the low mask quality and thus, would safeguard against failures associated with mask quality. (Emphasis added) (Paper 274 at 73).

Anderson's argument is not persuasive for the following reasons. First, Anderson argues that Drs. Mizrahi and Erdogan studied fiber photosensitivity because they were unsuccessful at obtaining a phase mask. Several of the dates listed for studying photosensitivity and grating growth rates (Paper 274 at 74-75) are prior to the 19 November 1992 date when Anderson directs us to the first activity of trying to make or obtain a phase mask. Up until then, we do not know that the inventors were "unsuccessful at obtaining a phase mask" as argued by Anderson. The record does not support the argument that the inventors were unsuccessful. Rather, based on this record, Anderson has failed to sufficiently demonstrate that the inventors did anything, prior to 19 November 1992, towards obtaining **[*33]** or making a phase mask.

Anderson additionally argues that since the inventors knew that they would obtain a mask of low quality, that they would need to study the photosensitivity of fibers and that a fiber with high photosensitivity could compensate for a low mask quality. Anderson has failed to direct us to evidence that would demonstrate that the inventors tried to obtain or make a phase mask prior to 19 November 1992, or that they knew they would have to use a mask of low quality.

The evidence that Anderson does direct us to (e.g., AR 280-281; AR 821-823, lines 18-19) in support of its argument does not support that the inventors knew, at the time they did photosensitivity studies, that they might have to use a phase mask of low quality. For these additional reasons, Anderson has failed to establish that it was diligent during the critical time period.

Although not necessary to our decision, we also address Anderson's other activities that Anderson argues are directly relevant to practicing the count to practice. Those other activities are 1) work to optimize beams of grating writing equipment and 2) maintaining the grating writing equipment (Paper 274 at 75-78).

The grating writing **[*34]** equipment used by Drs. Erdogan and Mizrahi was an interferometer laser. The laser was used in the latter part of November 1992 in attempts to make a phase mask by etching a pattern in the mask using the laser. Prior to those activities, Anderson has failed to sufficiently demonstrate that the inventors used the laser to reduce the invention to practice.

The evidence that Anderson directs us to in support of its argument that the laser, and maintenance of such equipment, were used to reduce the invention to practice are directed to those events that occurred in the latter part of November 1992 for making a phase mask. Anderson fails to sufficiently explain how the earlier listed dates (Paper 274 at 76) of using the interferometer or maintaining the interferometer were directly related to reducing the invention to practice.

Specifically, Anderson fails to direct us to sufficient evidence that would explain the experimental use of the grating writing equipment and maintenance thereof, as it applies to reducing the invention to practice.

The difficulty with Anderson's diligence case is that there is no demonstration, supported by sufficient evidence, that the inventors were performing **[*35]** all of the other tasks with the goal in mind of reducing the invention to practice. In April 1992, prior to Anderson's alleged conception, Dr. Mizrahi was interested in growing Bragg gratings in optical fibers by exposing the fibers to an interference pattern formed by overlapping two beams of ultraviolet light from an interferometer (AR 1-2, P4). It is not until 19 November 1992 that Mizrahi even mentions in his lab notebook entries of attempting to reduce the claimed invention to practice. Up to that point, there is not sufficient evidence that Mizrahi, or Erdogan were performing the "related activities" with the goal in mind of reducing the invention to practice. Anderson relies on attorney argument to assert that the inventors did perform the "related activities" with the goal in mind of reducing the invention to practice. However, argument by counsel cannot take the place of evidence lacking in the record.

The reasonable diligence standard "balances the interest in rewarding and encouraging invention with the public's interest in the earliest possible disclosure of innovation." Griffith v. Kanamaru, 816 F.2d 624, 626, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987). **[*36]** Here, Anderson has failed to sufficiently demonstrate that it was reasonably diligent such as to provide the public with the earliest possible disclosure of its invention.

Where the first to conceive has failed to demonstrate that it was reasonably diligent during the critical period, there is no reason, or justification, to allow it to prevail over another who is the second to conceive but who has made prompt disclosure by the filing of a patent application.

For all of the above reasons, Anderson has failed to sufficiently demonstrate by a preponderance of the evidence that it was prior to either Snitzer or Hill. Accordingly, judgment against Anderson is now appropriate.

Hill's case on priority

Actual Reduction to Practice

In order to establish an actual reduction to practice, the inventor must prove that: (1) an embodiment was constructed or a process was performed that met all the limitations of the interference count; and (2) that the invention would work for its intended purpose. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000). See also UMC Elecs. Co. v. United States, 816 F.2d 647, 652, 2 USPQ2d 1465, 1468 (Fed. Cir. 1987); **[*37]** ("There cannot be a reduction to practice of the invention . . . without a physical embodiment which includes all limitations of the claim.") (Emphasis added); and Corona Cord Tire Co. v. Dovan Chem. Corp., 276 U.S. 358, 383 (1928); (A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed; quoted in Pfaff v. Wells Electronics, Inc., 119 S.Ct. 304, 307 n.2 (1998)). Corroboration of an actual reduction to practice is also required.

Hill's alleged actual reduction to practice fails for several reasons. First, the alleged actual reduction to practice was not actually reduced. The description of the Hill manuscript is not sufficient to demonstrate that the method of the count was actually performed. "Unlike the filing of a patent application, the publication of an article is not deemed a constructive reduction to practice of the subject matter described therein." In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17(CCPA 1982). **[*38]**

Even further, Hill has failed to direct us to evidence of corroboration of the testing allegedly performed as described in the Hill manuscript. Lastly, Hill cannot rely on its activities in Canada to demonstrate an actual reduction to practice in the United States. See Shurie v. Richmond, 699 F.2d 1156, 216 USPQ 1042 (Fed. Cir. 1983).

For these reasons, Hill has failed to sufficiently demonstrate that it actually reduced the invention to practice.

Diligence

Hill alternatively argues that it was diligent from the time of its conception, 8 September 1992 until the time the involved Hill application was filed, on 29 October 1992 n14. Hill need only show, however, that it was diligent from a time prior to Snitzer's 20 October 1992 filing until its 29 October 1992 filing. 35 U.S.C. § 102(g). The date of activity that Hill relies on that is prior to 20 October 1992 is 14 September 1992, when a letter was sent to Mr. Pascal, a patent agent, soliciting for a cost estimate for writing a patent application for the Hill invention. Hill directs us to no other evidence of acts of diligence from 14 September 1992 **[*39]** until its application is filed on 29 October 1992.

n14 Neither Anderson nor Snitzer argue that the Hill manuscript fails to constitute a conception of the interfering subject matter. Snitzer, however, objects to the admissibility of the Hill manuscript, the receipt from the Annual Review Office, and the marked-up Hill manuscript. For reasons provided, infra, those documents are admissible. The Hill manuscript does describe the method of the count (Finding 48). Thus, Hill has proved, by a preponderance of the evidence, a prior conception of the interfering subject matter by 8 September 1992.

Hill argues that it is clear that the Hill patent application had to be prepared during the time period between 8 September 1992 and 29 October 1992 (Paper 272 at 42). Hill relies on Shindelar v. Holdeman, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980) for the proposition that three months is considered a reasonable amount of time for preparing a patent application.

The facts here are distinguishable from those in Shindelar. The issue in Shindelar was whether a party had suppressed or concealed the invention after it had reduced the invention **[*40]** to practice. Here, the issue is diligence towards reducing an invention to practice, not whether an already reduced to practice invention has been concealed or suppressed. Hill has failed to discuss in any meaningful way why Shindelar applies to the issue of diligence.

Even if Shindelar should be considered with respect to the facts in this case, Shindelar does not stand for the proposition that three months to prepare an application is per se reasonable, when there is no evidence based on the record, to support a three month preparation time. In Shindelar, there was evidence of acts towards preparing the application. Here, there are none.

More relevant to the facts of this interference are D'Amico v. Koike, 347 F.2d 867, 146 USPQ 132 (CCPA 1965) and Bey v. Kollonitsch, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986). In D'Amico V. Koike, an unexplained one month period of time during the critical period was found to be excessive. In D'Amico, Judge Rich, speaking for the CCPA stated that:

> We agree with the general principles which appellant seems to be **[*41]** advocating, namely, that a rule of reason should be followed in cases of this kind and that courts should be somewhat liberal in determinations of diligence of attorneys and of their clerical and stenographic staffs, since the law cannot presume that such people can immediately begin and expeditiously perform their duties as soon as work appears on their desks. Nevertheless we think that appellant is attempting to use those principles as substitutes for record evidence, of which there is very little.
>
> As we view this appeal, appellant asks us to rule that even after a patent application is in draft form, with finished drawings, the acts of (1) considering and approving the application by a supervisory attorney, (2) final checking, (3) placing the approved and checked draft application in final form, and (4) preparing the formal papers for execution constitute "reasonable diligence," within the meaning of 35 U.S.C. § 102(g), if performed within a period of two months.
>
> Obviously such a ruling must depend on a great number of circumstances such as, but not limited to, complexity of the invention, length of the application, detail of the drawings, experience, **[*42]** workload and availability of the attorney, availability of the draftsman and the inventor during the period involved, size of the attorney's staff, procedure and policy in reviewing the application, type and thoroughness of the review, number of people involved in preparing the application and their location, and the number of changes which the subject application underwent.
>
> Certainly, evidence as to all these factors need not be of record; possibly evidence as to only one or two would suffice in certain cases. However, in the present appeal we know essentially nothing about the handling of the application during the two-month period except that (a) Breen did in fact "consider and approve" the application, and (b) the other work, i.e., checking, placing in final form, and preparing the formal papers, was done sometime. There is no end to the inferences which might be drawn from the scanty record before us and we prefer not to indulge in them, but we cannot overlook the fact that Koike's priority date falls nearly midway in this two-month period and it is certainly possible that all of D'Amico's activity took place during the period prior to October 29, whereupon the application lay **[*43]** idle for nearly one

month awaiting execution by the inventor. Be that as it may, that month is the critical month and the record contains no evidence, even of the weakest sort, whether in it anything occurred. (347 F.2d at 871, 146 USPQ at 135).

Like D'Amico, Hill provides little or no evidence as to what occurred during the period between 14 September 1992 and 29 October 1992. Hill fails to direct us to evidence that would even explain Mr. Pascal's activities.

Further, while the diligence law permits an attorney to work on his backlog and related cases, the law also specifies that "the attorney has the burden of keeping good records of the dates when cases are docketed as well as the dates when specific work is done on the applications." Bey v. Kollonitsch, 806 F.2d at 1028, 231 USPQ at 970. Here, no dates or records of Mr. Pascal's activities have been offered into evidence.

For these reasons, Hill has failed to demonstrate by a preponderance of the evidence that it was diligent during the critical period.

Hill's charge of derivation and Snitzer's prior conception

We begin our discussion **[*44]** with Snitzer's prior conception. A showing of prior conception by Snitzer will negate Hill's charge of derivation.

The Snitzer inventors arrived at the idea of disposing a periodic object mask adjacent and parallel to a photosensitive optical waveguide and applying a single collimating light beam through the mask on 21 July 1992. The Snitzer inventors contemplated that "periodic object mask" included phase masks as well as amplitude masks (Finding 97).

Snitzer relies on its Invention Questionnaire, testimonial evidence of Dr. Rishton, and Dr. Stubbs and inventor testimony of Dr. Prohaska that he performed calculations on phase masks at the end of July 1992 to demonstrate independent corroboration of its conception (Paper 278 at 40).

Snitzer relies on the questionnaire to show all features of the count with the exception of a specific reference to using a phase mask. Snitzer relies on the testimonies of Drs. Stubbs and Rishton, along with activities of Dr. Prohaska to corroborate that the Snitzer inventors conceived of using a phase mask (Paper 278 at 44-45).

We begin our analysis by assessing the credibility of the testimony of Dr. Rishton. Snitzer relies on Rishton's testimony to **[*45]** corroborate the Snitzer inventors allegations that they had discussed with Rishton using a phase mask for forming Bragg gratings in late July 1992. Dr. Rishton's declaration and cross-examination testimony were taken some nine years after the events to which he testified. That this is a long time for a person to recollect events is exemplified by Dr. Rishton's inability to recall certain events that occurred during the same time period for which he testified (Findings 113-116).

Initially, during his cross examination, Dr. Rishton could not recall the term phase mask being mentioned to him during his meetings with Drs. Snitzer and Prohaska (Finding 111). Dr. Rishton recalled much later during his cross-examination testimony, that the term phase mask was discussed. Thus, there is a conflict in Dr. Rishton's testimony.

Hill argues that Dr. Rishton was confused about when the Snitzer inventors and he discussed phase masks. Apparently, there were subsequent discussions, after the alleged prior conception, between the Snitzer inventors and Dr. Rishton about Dr. Rishton making a phase mask. Dr. Rishton did eventually make a phase mask in 1993 for the Snitzer inventors (Finding 108). In support **[*46]** of Hill's argument that Dr. Rishton was confused, Hill directs us to Rishton's cross-examination, where Rishton states that during the initial conversation with Dr. Snitzer, that Dr. Snitzer had described phase masks "according to their calculations." However, according to Prohaska's testimony those calculations had not yet been made

(Finding 117). According to Hill, Dr. Rishton's recollection may be based on a subsequent conversation he had with Dr. Snitzer regarding phase masks - a conversation that occurred after Snitzer's alleged July 1992 prior conception date.

Further, although Dr. Rishton routinely kept notes regarding meetings, the notes he kept for the initial discussions he had with the Snitzer inventors only mention an amplitude mask and do not mention any discussion Rishton had with either Snitzer or Prohaska regarding a phase mask or the concept of a phase mask. That alone is not fatal to Snitzer, since oral corroboration of conception may by itself be sufficient. However, the lack of written documentation by Dr. Rishton, despite Snitzer's explanation that Dr. Rishton only recorded what was important to him, of phase mask or the concept of a phase mask during the initial **[*47]** conversation in late July 1992 supports the view that discussion of a phase mask did not occur in the initial conversation. We find that Dr. Rishton's testimony is not sufficiently credible to establish corroboration of the alleged conception.

Neither Dr. Rishton during cross-examination, nor party Snitzer sufficiently explain the noted conflicts in Dr. Rishton's cross-examination testimony. Snitzer, in its reply, argues that Dr. Rishton was initially referring to a class of grating masks and that his testimony was consistent in that he did not recall any other classes of masks being discussed (Paper 306 at 17). It is not evident that Dr. Rishton was referring only to a class of masks from his testimony. Dr. Rishton was asked specifically whether other terms beside grating masks were used by Dr. Snitzer or Dr. Prohaska during the initial conversation. Dr. Rishton testified that there were not (Finding 111). The question was not whether other terms for classes of masks were used, but rather any "other terms".

Snitzer further argues that Hill's argument that Rishton was confused about when he discussed phase masks is without merit (Paper 306 at 11). Specifically, Snitzer argues **[*48]** that Hill's theory is inconsistent with Dr. Rishton's testimony that during the initial conversation with the Snitzer inventors both phase and amplitude masks were discussed, and with Dr. Rishton's recollection that he informed the Snitzer inventors that he could not make a phase mask since he did not have an established process for doing so.

Snitzer fails to provide a sufficient explanation for why Hill's theory is wrong. It is correct that Dr. Rishton testified that during the initial conversation the term phase mask was discussed. However, it is also true that Dr. Rishton later recalled that no other term was used to refer to the masks discussed, other than grating mask. Furthermore, Snitzer fails to provide a sufficient explanation for Rishton's testimony that his recollection of discussing phase masks was based on calculations on phase masks that the Snitzer inventors performed. The calculations, however were performed subsequent to the alleged conception date. As likely as it is that Dr. Rishton did discuss with the Snitzer inventors phase masks during the July 1992 meetings, it is equally as likely, based on this record, that Rishton was confused about the timing of the conversations **[*49]** he had with the Snitzer inventors.

Under these circumstances, and while the matter may not be free from doubt, we find that Snitzer has failed to convincingly establish that Dr. Rishton's testimony, either alone or in combination with Drs. Prohaska's and Stubbs' testimony and the Invention Questionnaire, corroborate Snitzer's alleged conception.

Lacking from the record is sufficient credible testimony to permit us to accurately determine, as a matter of fact, that a phase mask, or the concept of a phase mask, was discussed during the initial conversations between Drs. Snitzer, Rishton, and Prohaska. While there is a possibility that a phase mask, or the concept of a phase mask was discussed, a possibility is not sufficient. Rather, a preponderance of the evidence must establish that a phase mask, or the concept of a phase mask was discussed during the initial meetings. A preponderance of the evidence is not based on mere possibilities.

Snitzer further relies on the uncorroborated oral testimony of inventor Dr. Prohaska to demonstrate that Dr. Prohaska performed phase mask calculations within about one to two weeks of 21 July 1992 (Paper 278 at 53). Snitzer fails to provide corroboration **[*50]** of the calculations. Note, inventor testimony must be corroborated. Cooper v. Goldfarb, 154 F.3d 1321, 1330, 47 USPQ2d 1896, 1903 (Fed. Cir. 1998).

Snitzer lastly relies on the testimony of Dr. Stubbs, the patent agent that prepared the Snitzer application. Snitzer argues that Dr. Stubbs corroborates the Snitzer inventors' conception of the invention by the end of July 1992 (Paper 278 at 54). On 30 July 1992, Dr. Stubbs met with Dr. Snitzer to discuss the Snitzer inventors' invention.

Dr. Stubbs testified that, based on a meeting with Dr. Snitzer on 30 July 1992, he believed that a mask having any form of periodic variation in optical properties was within the invention, whether they affected phase or amplitude of the transmitted light (Finding 126). Stubbs' belief does not establish corroboration of using a "phase grating mask" as recited in the count and as defined in this interference (Findings 10-18).

Snitzer is correct that conveyance of the precise terms of the count is not necessary to demonstrate conception. Rather, as Snitzer has pointed out, the subject matter defined by the count must be conveyed. In this interference, phase **[*51]** mask, or phase grating mask is a transparent mask having varying thickness across the mask, to vary the phase of the transmitted light (Finding 10). According to Stubbs, a mask that varies phase or amplitude is a part of the Snitzer invention. However, it has not been demonstrated that Stubbs understood that the inventors actually contemplated using a phase grating mask, or the concept of a phase grating mask, e.g. a mask having varying thickness across the surface of the mask (Finding 10). Snitzer's disclosure to Dr. Stubbs could have been very generic without mentioning any specifics.

We are also not persuaded by Snitzer's argument that prior art that demonstrates that phase masks were known in 1984 as transmission gratings is consistent with Dr. Stubbs' understanding of the Snitzer's invention. That it might have been obvious to use known phase masks to vary phase is not the point. Snitzer has failed to demonstrate that Stubbs' understanding is the same as what the inventors had in mind.

In any event, we find Stubbs testimony not to be credible. Dr. Stubbs, in his declaration, testified that during the 30 July 1992 meeting, Dr. Snitzer made it clear to him that a mask having any **[*52]** form of periodic variation in optical properties was within the invention, including a mask that affected phase or amplitude. During cross-examination, however, Stubbs had no recollection of the discussions he had with Dr. Snitzer during that meeting (Finding 121). Notes taken during the meeting do not sufficiently describe the concept of a phase mask as defined in this interference (Snitzer Ex. 3034). Accordingly, Stubbs testimony is inconsistent and not reliable.

Snitzer argues that Stubbs lack of recollection of the precise term "phase mask" is not critical, since it is the conveyance of the concept that is important. However, as pointed out by party Anderson, Stubbs not only testified that he did not recall the specific term "phase mask" being used, he also had no recollection of the discussions he had with Dr. Snitzer during the 30 July 1992 meeting. Snitzer does not provide a sufficient explanation for Stubbs' inconsistent testimony. Thus, we do not credit Stubbs testimony that on 30 July 1992, he discussed with the Snitzer inventors a mask having any form of periodic variation in optical properties, including a mask that affected phase or amplitude.

For the above reasons, Snitzer **[*53]** has failed to establish corroboration of its alleged conception of the subject matter of the count.

Derivation is a question of fact. To prove derivation, the movant must establish prior conception of the claimed subject matter and communication of the conception to the adverse claimant. Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993).

It is well established that derivation is difficult to establish by direct evidence; it can generally only be established from the circumstances of a case. Barnet v. Wied, 195 F.2d 311, 93 USPQ 161 (CCPA 1952). Accordingly, all the circumstances in the record must be considered in evaluating the sufficiency of the communication. Hedgewick v. Akers, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974).

Although there is no direct evidence that Elias Snitzer received and read the Hill manuscript, the facts

before us present strong circumstantial evidence which support Hill's charge of derivation.

Dr. Snitzer was a guest editor for the Annual Review of Materials Science, Volume 23. In early **[*54]** April 1992, Dr. Snitzer invited Dr. Hill to write an article for the Review (Finding 65). Dr. Hill prepared a fax of an outline of the Hill manuscript to send to Dr. Snitzer, allegedly per the request of Dr. Snitzer. Around the same time, per Dr. Hill's testimony, Cooperman the production editor for the Review sent a letter to Dr. Hill confirming that he agreed to write an article for the Review. After which, also per Dr. Hill's testimony, Dr. Snitzer requested that the manuscript be sent directly to him. Dr. Hill further testified that in May of 1992, a second Cooperman letter was sent to Dr. Hill informing him that a copy of his manuscript should be sent directly to the Annual Review Office and not to the guest editors as either guest editor had previously requested (Finding 72).

The Hill manuscript was received by the office for the Review on 8 September 1992 (Findings 49 and 54). The Hill manuscript describes all of the elements of the count. Although there is no direct evidence that Dr. Snitzer received the Hill manuscript, Cooperman testified that for the Volume 23, in the ordinary course of business, she sent copies of all manuscripts for keynote topics to each editor to be **[*55]** read (Findings 75 and 76). Cooperman further testified that a copy of each manuscript was sent to the guest editors immediately after the manuscript was received by the Annual Review Office (Finding 75).

Almost six weeks after the Annual Review Office received the Hill manuscript, the Snitzer inventors, on 17 October 1992, amended their '839 parent application by inserting an express reference to using a mask with periodic variation in phase for forming Bragg gratings in optical fibers. The Snitzer inventors testified that they were surprised when they initially read a draft of their '839 application and noticed that a reference to phase masks was not in the application contrary to Dr. Prohaska allegedly requesting that Dr. Stubbs, their patent agent, insert such a reference. Dr. Stubbs does not recall a conversation with Dr. Prohaska requesting to add an embodiment for a phase mask to the '839 application, or ever discussing phase masks with the Snitzer inventors (Findings 122 and 123). The single insert is the only description in '839 that refers to a "phase mask."

In the early part of 1993, Dr. Snitzer wrote and faxed an insert for the introduction for the Volume 23 (Finding 78). **[*56]** Even though the insert does not describe the elements of the count, it does describe writing gratings in fibers and using optical fibers for communications and sensing. Thus, the insert describes the general subject matter of the Hill manuscript. Hill argues that the insert is further evidence that Dr. Snitzer had read the Hill manuscript contrary to Dr. Snitzer's testimony. Dr. Snitzer testified that he never read the Hill manuscript prior to or during the pendency of his '839 application, which issued well after the time he wrote the insert for the Volume 23 (Findings 87 and 88).

Snitzer's side of the story is as follows. Snitzer argues that Dr. Snitzer was very busy at the time he took on the role as guest editor for the Annual Review of Materials Science. Dr. Snitzer testified to this and testified that the late Dr. Laudise, the other guest editor for the Volume 23, performed almost all of the guest editing work (Findings 90 and 91).

Dr. Snitzer testified that in connection with his position as guest editor, he solicited authors, received two manuscripts (that Dr. Laudise sent to him specifically to review) and provided an insert for the introduction to the Volume 23. Snitzer **[*57]** further relies on the testimony of Mr. Wachtman, one of the associate editors for the volume. Wachtman testified that Dr. Snitzer was busy at the time Dr. Snitzer was guest editor for Volume 23, and that it was his opinion that Dr. Laudise took on a strong interest in the Volume 23 and that Dr. Snitzer relied on Dr. Laudise for direction.

Dr. Snitzer further testified that he sent all pertinent information that pertained to the subject matter of his patent application to Dr. Stubbs and that he did not send him a copy of the Hill manuscript. He also testified that he searched his files and did not find a copy of the Hill manuscript.

We are not persuaded by Snitzer's explanations. First, we credit the testimony of Dr. Hill over that of Dr. Snitzer, since at least Cooperman corroborates portions of Dr. Hill's testimony.
Further, Wachtman testified that it was his perception that Dr. Snitzer was busy at the time Dr. Snitzer was

a guest editor. However, Wachtman's testimony is based on his opinion, not on first hand knowledge. That Dr. Snitzer appeared to be busy with duties outside of being a guest editor does not indicate that the Hill manuscript was never sent to him. Further, that **[*58]** Dr. Snitzer searched his files for a copy of the Hill manuscript is weighed in light of his testimony that he was not very good at keeping files (Finding 94). Dr. Snitzer's and Mr. Wachtman's testimony, when weighed against the circumstantial evidence that Hill has directed us to is not persuasive.

Snitzer attacks the credibility of Cooperman's testimony. Snitzer argues that since Cooperman dealt with numerous manuscripts, authors, editors, etc., during 1993, that she is mistaken in her assumption of how the manuscripts for Volume 23 of the Review were handled (Paper 289 at 42). That Cooperman dealt with a large number of manuscripts, authors and editors does not, without more discredit Cooperman's testimony. Cooperman was consistent throughout her testimony. She testified that for Volume 23, a copy of each manuscript for the keynote topic was sent to each guest editor (Findings 75 and 76). Organizing and orchestrating each Volume was and still is (as of the date of her deposition and cross-examination testimony) Ms. Cooperman's job as production editor (Findings 52 and 53). As part of her job, Ms. Cooperman performs certain routine tasks. We are not persuaded that the shear volume **[*59]** of information that Ms. Cooperman dealt with in 1993 discounts her consistent recollection of how manuscripts were handled for Volume 23.

Snitzer additionally argues that it was possible that Cooperman only sent one copy of the Hill manuscript to Dr. Laudise and not to Dr. Hill (Paper 289 at 41). Snitzer directs us to the Cooperman May 12, 1992 letter in which the letter indicates that one copy of the manuscript sent by Dr. Hill will be sent to the senior editors (Finding 73). Snitzer argues that the reference to "senior editors" in the letter was correct and even if it was supposed to be guest editors, that the letter indicates that only one copy was sent to the guest editors, and that it was likely that the one copy was sent to Dr. Laudise. This, Snitzer argues, coupled with Cooperman's testimony that she would have only sent copies of manuscripts to Dr. Laudise, if he had so requested, evidences that Dr. Laudise received the Hill manuscript and not Dr. Snitzer.

Snitzer has moved to exclude the May 12, 1992 Cooperman letter. In our discussion that follows, we agree with Snitzer that the letter is hearsay and have excluded the letter from consideration. Thus, Snitzer cannot rely **[*60]** upon the letter in support of its theory. In any event, Snitzer's theory does not discredit or outweigh the testimony of Cooperman that during the regular course of business for the Volume 23, a copy of each manuscript was sent to each guest editor. We find the Cooperman testimony credible. Although Cooperman testified affirmatively that she would have only sent copies of the manuscript to Dr. Laudise, if he had so requested, there is no convincing evidence based on the record before us that indeed that is what happened. Cooperman testified specifically that she did not think that she had sent the Hill manuscript only to Dr. Laudise (Finding 77).

Snitzer argues that the insert that Dr. Snitzer wrote for the introduction of Volume 23 is a general overview of relevant topics in the field of fiber optics, and does not demonstrate that Dr. Snitzer read the Hill manuscript (Paper 289 at 45). While it may be true that the insert may refer to a general overview of relevant topics in the field of fiber optics, it is at least as likely that the insert was written with knowledge of the Hill manuscript. Cooperman indicated that one of the reasons for sending the keynote manuscripts to the guest **[*61]** editors was for them to read the manuscripts in order to write an introduction for the volume (Finding 83). It is suspect that Snitzer would take on the task of writing a portion of an introduction for a publication without knowing what had been written. Snitzer's explanation to the contrary, in light of the evidence before us, is not persuasive.

In summary, although Dr. Snitzer denied ever reading or receiving the manuscript, based on the record, there is strong circumstantial evidence supporting Hill's charge of derivation.

The Annual Review Office received Hill's transcript on 8 September 1992. Cooperman testified that for Volume 23 a copy of each manuscript covering a keynote topic was sent to each guest editor. Her testimony is unwavering and credible. Dr. Snitzer wrote an insert for the introduction of Volume 23, describing generally the subject matter covered by the Hill manuscript, despite Dr. Snitzer's testimony that he never received or read Hill's manuscript. Cooperman testified that manuscripts are sent to each guest

editor to be read in order to write an introduction. It is simply not credible that Snitzer would undertake writing a portion of an introduction to a compilation **[*62]** of articles without reading the relevant articles. The Snitzer inventor's inserted a reference to using a "phase mask" in the '839 application approximately six weeks from when the office for the Review received the Hill manuscript and from when the manuscript was sent to the guest editors.

Snitzer has failed to provide a sufficient explanation for making the insertion in the '839 application without Snitzer's first having read the Hill manuscript. As stated above, in connection with Snitzer's alleged earlier conception, Snitzer has failed to sufficiently demonstrate that it conceived of the invention prior to 17 October 1992, when the Snitzer inventors amended their application. Snitzer's alleged prior conception and explanation for why the Snitzer inventors inserted the phase mask embodiment in their '839 application lack corroboration. The lack of a sufficient explanation for the insert in Snitzer's '839 application is further compelling evidence that tends to support Hill's charge of derivation.

Based on the record before us, Hill has sufficiently demonstrated by a preponderance of the evidence that Snitzer derived the invention of the count from party Hill. Snitzer has failed **[*63]** to demonstrate otherwise.

Snitzer's Miscellaneous Motion to Suppress Anderson's evidence

We find it unnecessary to consider the specific objections to the admissibility of Anderson's exhibits 1029-1031, 1033 and 1034, since Anderson has failed to demonstrate priority by a preponderance of the evidence even assuming Anderson's exhibits 1029-1031, 1033 and 1034 to be admissible.

Accordingly, Snitzer's miscellaneous motion 10 to suppress is dismissed as moot.

Snitzer's Miscellaneous Motion to Suppress Hill's evidence

Snitzer moves to have certain ones of Hill's exhibits excluded from consideration (Finding 124). Hill exhibits 2008, 2030, 2046, Attachment I to 2046, Attachment II to 2046, 2057, 2059, and Anderson Ex. 1024 were apparently not relied upon by Hill to demonstrate conception and/or derivation, nor were they considered in rendering our decision regarding Hill's case of conception and/or derivation.

Furthermore, Hill's case of diligence was found not to be persuasive since Hill failed to sufficiently demonstrate acts of diligence from 8 September 1992 until 29 October 1992. Hill's demonstration of reduction to practice on 8 September 1992 was rejected, since Hill **[*64]** failed to demonstrate that the testing described in the Hill manuscript was actually performed, corroborated, and performed in the U.S.

Thus, we find it unnecessary to consider the specific objections to the admissibility of Hill's exhibits 2008, 2030, 2046, Attachment I to 2046, Attachment II to 2046, 2057, 2059, and Anderson Ex. 1024, since Hill has failed to demonstrate a prior reduction to practice or diligence by a preponderance of the evidence even assuming Hill's exhibits 2008, 2030, 2046, Attachment I to 2046, Attachment II to 2046, 2057, 2059, and Anderson Ex. 1024 to be admissible for purposes of demonstrating diligence and an earlier reduction to practice.

Accordingly, Snitzer's motion with respect to Hill Ex. 2008, 2030, 2046, Attachment I to 2046, Attachment II to 2046, 2057, 2059, and Anderson Ex. 1024 is dismissed as moot.

Snitzer moves to exclude the Snitzer facsimile allegedly sent by Dr. Hill to Dr. Snitzer (Hill Ex. 2044, Attachment I to 2045, and references in Hill Ex. 2045 to such). Snitzer argues that the fax is hearsay, it includes handwritten marks, has not been properly authenticated, and no original is provided. Hill does not offer the fax into evidence to **[*65]** prove the truth of the matter asserted in the fax. Rather, Hill submits the fax into evidence to demonstrate that Dr. Snitzer was interested in Dr. Hill's work (Finding 69). Accordingly, the evidence is not hearsay.

Snitzer also challenges the authenticity of the fax. However, Hill testifies as to the authenticity of the fax,

e.g. that it was a fax sent by him to Dr. Snitzer (HR 6, P5). No more is needed. Furthermore, the Federal Rules of Evidence allow a party to provide a copy of a document. See FRE 1003 (duplicates admissible to the same extent as originals). Accordingly, Snitzer's motion to exclude Hill exhibit 2044, Attachment I to 2045, and references in Hill exhibit 2045 to such, is denied. With respect to Dr. Hill's testimony concerning what the fax demonstrates, e.g. what the contents of the fax mean, we have not considered those statements, since party Hill apparently does not rely upon them to prove conception. However, those statements made by Dr. Hill regarding his recollection of sending the fax are admissible.

Snitzer moves to exclude the April 1992 Cooperman letter and references thereto (Hill Ex. 2016, paragraph 3; Attachment I to 2016; Hill Ex. 2045, paragraphs **[*66]** referring to Attachment II of 2045, and Attachment II to 2045). Hill has failed to sufficiently address Snitzer's argument that Cooperman has failed to demonstrate that the letter falls within the business record exception. Accordingly, the letter is excluded. However, admissible is the statement made by Hill that he received the letter from Cooperman and the statement from Cooperman that the letter was from her to Dr. Hill.

Snitzer moves to exclude the May 1999 Cooperman letter and references thereto (Attachment VII to 2045 and portions of 2045). Hill fails to demonstrate that the May 1999 letter falls under a hearsay exception. Accordingly, the letter is excluded. Hill's declaration regarding the content of the letter has also not been considered. However, statements made by Hill that he received the letter from Cooperman are admissible. Furthermore, paragraph 29 of Hill exhibit 2045, is also excluded, since Hill's conclusions are based on the May 1999 Cooperman letter (HR 15, P29). Accordingly, Snitzer's motion to exclude Attachment VII of 2045 and paragraphs 28 and 29 of 2045 (HR 15) is granted.

Snitzer seeks to exclude the Hill manuscript receipt and references thereto (Hill **[*67]** exhibit 2016, paragraph 4, Attachment II to 2016, Attachment V to 2045, and paragraphs referring to Attachment V of 2045). Snitzer argues that the reference to and the copy of the receipt contain hearsay without a sufficient foundation to invoke any hearsay exception. The receipt and reference to the receipt fall within the business record exception.

Snitzer argues that Hill, in its opposition, failed to specifically cite to where in Cooperman's testimony it is provided that the Annual Review Receipt was kept in the course of a regularly conducted business activity (Paper 281 at 10). Hill, in its opposition specifically states that Cooperman's testimony (HR 270) and supplemental Cooperman declaration provide that explanation (Paper 293 at 9).

Cooperman testified as to the specific steps she takes to date and stamp a manuscript received and that a receipt is stamped with the same date and sent to the author (HR 270-271). Cooperman further testified that the receipt was made as part of the usual activities of the Office of the Annual Review of Materials Science (HR 221, P7 - the receipt "has my signature thereon, and is the type of receipt I sent out in the ordinary course of business **[*68]** when a manuscript was received"). Nothing more is needed. Accordingly the receipt and paragraphs of the declarations referring to such are admissible.

Snitzer moves to exclude the May 1992 Cooperman letter and references thereto (Attachment III to 2045 and portions of 2045) as being hearsay. While the letter is highly relevant and corroborates Hill's testimony that Dr. Snitzer had requested that the Hill manuscript be sent directly to Dr. Snitzer, the letter is hearsay and Hill has failed to demonstrate that it falls under a hearsay exception. Accordingly, the Cooperman May 1992 letter is inadmissible. Snitzer also argues that paragraph 16 of 2045 is hearsay with respect to the May 1992 letter. Dr. Hill's testimony attesting to what the letter says or what it means has not been considered. However, Dr. Hill's testimony that 1) he received the letter from Cooperman; and 2) that Elias Snitzer had requested that the manuscript be sent directly to him are admissible.

Snitzer seeks to exclude the Hill manuscript (Attachment IV to 2045) as containing hearsay. Hill relies on the manuscript to demonstrate conception of the invention. Dr. Hill testified as to the contents of the manuscript **[*69]** and that he and the other Hill inventors conceived of the invention as demonstrated by the manuscript. Thus, Hill testified that he, along with the other Hill inventors conceived of the invention and that the manuscript describes the elements of the count.

We disagree that the Hill manuscript is hearsay. Hill is not relying on the manuscript for the truth of the matter asserted, e.g. that the contents of the manuscript are truthful. Rather, Hill is relying on the manuscript to show that the elements of the count were described. Thus, the document is not hearsay and therefore is admissible.

Snitzer seeks to exclude the marked up version of the Hill manuscript (Attachment VI to 2045). The marked up manuscript is not hearsay, since Hill does not rely on the contents of the manuscript for the truth of the matter asserted. Rather, Hill relies on the manuscript in support of its contention that once the office of the Annual Review receives a manuscript it marks the manuscript with the date in which the manuscript was received. Thus, Hill relies on the marked up manuscript for the 8 September 1992 date stamped on the front of the cover of the manuscript. Cooperman testified that in the ordinary **[*70]** course of business, that manuscripts are routinely date stamped upon their arrival (HR 270, lines 1-23). Thus, Cooperman establishes that the stamp on the front of the Hill manuscript was done in the ordinary course of business.

Snitzer additionally argues that the handwritten notations added to the manuscript are illegible and as such the exhibit should be excluded. Hill is not relying on the handwritten notes in the manuscript. Accordingly, there was no occasion for Hill to have to properly authenticate the handwritten notes as Snitzer argues. For the above reasons, Snitzer's motion to exclude the marked up Hill manuscript is denied.

In it's case for derivation, Hill relies on exhibit 2058 as a comparison between the introduction of Hill's manuscript and the insert prepared by Elias Snitzer for the introduction to Volume 23 of the Review. Hill relies on this document to demonstrate the similarities between the two documents, in support of its derivation case, e.g. that Snitzer had read the Hill manuscript prior to drafting the insert to the Volume 23 introduction contrary to Dr. Snitzer's allegations that he had not read or received the Hill manuscript. Snitzer objects to this evidence, **[*71]** since 1) the exhibit has not been authenticated; 2) no witness has testified to having personal knowledge of the drafting or highlighting of the document; and 3) it is irrelevant.

We find that the comparison is relevant to the issues raised by Hill in its case for derivation. Furthermore, we find it unnecessary for a witness to testify as to the drafting, highlighting or general preparation of Hill exhibit 2058. Here, Hill has explained what the document shows. The trier of fact can look at the Hill manuscript and compare it with the insert made by Dr. Snitzer and see that Hill exhibit 2058 shows the two texts side-by-side. The trier of fact can also determine the similarities highlighted by Hill. Thus, the evidence is sufficient to support a finding that the matter in question is what its proponent claims. See Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577, 38 USPQ2d 1288, 1291 (Fed. Cir. 1996) (stating that the trier of fact can conclude for itself what documents show). Therefore, Snitzer's motion to suppress Hill exhibit 2058 is denied.

Anderson's Miscellaneous Motion to Suppress Hill's Evidence

Anderson failed to attach its **[*72]** objections to its motion to suppress Hill's evidence. Accordingly, the motion is dismissed on that ground alone.

Even considering Anderson's motion on the merits, the motion is dismissed for the following reasons. Anderson moves to suppress Hill exhibit 2044, the facsimile that Hill allegedly sent to Elias Snitzer on 24 April 1992. Anderson's objections to this document and to the declarations of Dr. Hill testifying as to the content of the fax, are based on the document demonstrating prior conception. Hill has made it clear that it does not rely on the fax to establish an earlier date of conception, e.g. earlier than its 8 September 1992 conception. Rather, Hill has submitted Exhibit 2044 to demonstrate an interest on the part of Elias Snitzer in Hill's work (Finding 69).

Anderson also objects to the admissibility of Hill exhibit 2045, paragraph 20, since Dr. Hill testifies that he made gratings with a phase mask by the spring of 1992. Hill does not rely on this statement to aver an earlier date of conception. Accordingly, we have not considered the exhibits 2044 or 2045 with respect to demonstrating a prior conception of 24 April 1992.

Accordingly, Anderson's motion to suppress **[*73]** Hill Exhibit 2044 and portions of Hill exhibit 2045 and 2048 is dismissed as moot.

D. Judgment

Based on our decision, it is

ORDERED that judgment as to Count 2 (Paper 209), the sole count in the interference, is awarded against junior party DANA Z. ANDERSON, TURAN ERDOGAN, and VICTOR MIZRAHI;

FURTHER ORDERED that junior party DANA Z. ANDERSON, TURAN ERDOGAN, and VICTOR MIZRAHI is not entitled to a patent containing claims 1, 2 and 5-8 (corresponding to Count 2) of U.S. Patent 5,327,515;

FURTHER ORDERED that judgment as to Count 2 (Paper 209), the sole count in the interference, is awarded against senior party ELIAS SNITZER, and JOHN D. PROHASKA:

FURTHER ORDERED that senior party ELIAS SNITZER, and JOHN D. PROHASKA is not entitled to a patent containing claims 11-23 and 25-30 (corresponding to Count 2) of application 08/310,426;

FURTHER ORDERED that a copy of this paper shall be made of record in the files of application 08/310,426, and U.S. Patent 5,327,515, and U.S. Patent **5,367,588;**

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

Source: Legal > Area of Law - By Topic > Patent Law > Multi-Source Groups > **Patent Cases from Federal Courts and Administrative Materials**
Terms: **5367588 or 5,367,588** (Edit Search | Suggest Terms for My Search)
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Anderson v. Hill, 66 U.S.P.Q.2d (BNA) 1113 (Bd. Pat. App. & Interferences Aug. 7, 2002)

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No subsequent appellate history.

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Other Sources: **Law Reviews (1)**

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LAW REVIEWS AND PERIODICALS (1 Citing Reference)

Select for Delivery

1. ARTICLE: A Critique of Recent Opinions in Patent Interferences n1, 86 J. Pat. & Trademark Off. Soc'y 464 (2004)

 86 J. Pat. & Trademark Off. Soc'y 464 p.469

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ARTICLE: A Critique of Recent Opinions in Patent Interferences n1

NAME: Charles L. Gholz n2

TEXT:

[*466] I. INTRODUCTION

This article covers precedential and interesting non-precedential opinions n3 relating to interferences published since those covered in my previous article at *85 JPTOS 401 (2003)* n4 through December 31, 2003. n5

II. CONCEPTION

Nothing relevant this year.

[*467] III. CLASSICAL DILIGENCE

Nothing relevant this year.

IV. ACTUAL REDUCTION TO PRACTICE

A. A COMPUTERIZED SIMULATION CAN CONSTITUTE AN ACTUAL REDUCTION TO PRACTICE OF A METHOD COUNT RECITING A METHOD STEP INTENDED TO BE PRACTICED BY A COMPUTER

1. Taskett v. Dentlinger

In *Taskett v. Dentlinger, 344 F.3d 1337, 68 USPQ2d 1472 (Fed. Cir. 2003)* (opinion by Circuit Judge Michel for a panel that also consisted of Circuit Judges Dyk and Prost), the court affirmed the board's holding that a computerized simulation constituted an ARP of a method count that recited, i.a., "obtaining financial authorization for said request by a central terminal...." n6 The losing party (Taskett) argued that the count required the winning party (Dentlinger) "to obtain actual 'financial authorization' from a third-party institution," n7 but the board had held that "the use of a switch at EDS (Dentlinger's employer) and a dummy [checking] account could satisfy the count." n8 The court agreed:

That Dentlinger did not test this step of the count under conditions of actual use does not mean that he did not reduce it to practice. His test was sufficient to determine that the invention would work for its intended purpose. To hold otherwise would be to require an inventor to have created a viable commercial embodiment before the Board or a court could find reduction to practice. This the law does not require. n9

COMMENT

There is still a shadow over use of computerized simulations to establish ARPs of apparatus counts and limitations of a method count not intended to be practiced in a computer. See, e.g., *McDonnell Douglas Corp. v. United States, 208 USPQ 728, 733* (Ct. of Cl. Tr. Div. **[*468]** 1980), rev'd, *214 USPQ 857, 860-62* (Ct. of Cl. 1982). However, there is no reason why a computerized simulation of a step intended to be practiced on a computer should not be judged by the same standards as any other simulation.

V. PEELER DILIGENCE

Nothing relevant this year.

VI. CONSTRUCTIVE REDUCTION TO PRACTICE

A. THE COURT CASTS DOUBT ON THE VENERABLE PROPOSITION THAT, FOR PRIORITY PURPOSES, A PRIOR APPLICATION NEED ONLY DISCLOSE A SINGLE SPECIES WITHIN THE SCOPE OF THE COUNT

1. Chen v. Bouchard

In *Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)* (majority opinion by Circuit Judge Lourie, joined by Circuit Judge Schall; opinion dissenting in part by Circuit Judge Newman), a panel of the board had "held that Chen's earlier applications did not satisfy the written description requirement for any embodiment within the [scope of the three] counts." n10 Nevertheless, the majority began its discussion with the statement that, "Whether a specification supports a claim corresponding to a count, and thus satisfies the written description requirement of *35 U.S.C. § 112,* P1, is a question of fact, *Vas-Cath v. Mahurkar, 935 F.2d 1555, 1562 (Fed. Cir. 1991)...*" n11 --despite the fact that whether the specification of Chen's patent in interference supported a claim corresponding to a count was not an issue before the court.

COMMENT

It has been the law since Hector was a pup that, for priority purposes (as opposed to the purpose of antedating a reference), a prior application need only disclose a single species within the scope of a count. n12 Of course, the question of whether a prior application **[*469]** adequately discloses a single species within the scope of a count is conceptually similar to the question of whether a prior application supports a claim for the purpose of antedating a reference, and it makes sense to treat both questions as either questions of fact or questions of law. However, the majority's conflation of the two issues n13 casts doubt on the court's continued adherence to this venerable proposition.

VII. DERIVATION

A. MERELY DENYING DERIVATION IS NOT ENOUGH

1. Anderson v. Hill

There are not many opinions finding derivation--perhaps because techies are an honest lot and perhaps because the APJs are reluctant to besmirch reputations. However, ***Anderson v. Hill, 66 USPQ2d 1113 (PTOBPAI 2002)*** (non-precedential) (opinion delivered by APJ Medley for a panel that also consisted of APJs Schafter and Lee), is an opinion finding that a prominent university professor (Elias Snitzer) derived the invention in issue. n14 Moreover, the panel found that Prof. Snitzer derived the invention while serving as one of the guest editors of the *Annual Review of Material Science* from Dr. Hill, the lead inventor in another party to this interference, who had submitted a paper describing the invention for publication in that review--an inflammatory allegation indeed!

I will start by reviewing the basics.

First:

Derivation is a question of fact. To prove derivation, the movant must establish prior conception of the claimed subject matter and communication of the conception to the adverse claimant. *Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993).* n15

Second, the testimony of named inventors offered in rebuttal to evidence of derivation offered by an opponent must be corroborated. n16

[*470] Third, notwithstanding the former language of *35 USC 102*(f), interferents have *always* been able to prove derivation taking place abroad. n17

Fourth, the burden of proof on the party alleging derivation is allegedly the preponderance of the evidence. n18 However, the board has traditionally indulged in a presumption of integrity which makes the burden on the party attempting to prove derivation *feel* like clear and convincing evidence. n19

Fifth, alleged derivers seldom confess, and smoking gun evidence is hard to find.

So:

It is well established that derivation is difficult to establish by direct evidence; it can generally only be established from the circumstances of a case. *Barnet v. Wied, 195 F.2d 311, 93 USPQ 161 (CCPA 1952).* Accordingly, all the circumstances in the record must be considered in evaluating the sufficiency of the communication. *Hedgewick v. Akers, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974).* n20

In this case, Prof. Snitzer strenuously denied having derived the invention from Dr. Hill's submission. However, his story just didn't hang together:

Although there is no direct evidence that Elias Snitzer received and read the Hill manuscript, the facts before us present strong circumstantial evidence which support Hill's charge of derivation. n21

[*471] In summary, although Dr. Snitzer denied ever reading or receiving the manuscript, based on the record, there is strong circumstantial evidence supporting Hill's charge of derivation. n22

COMMENT

Given the board's historic reluctance to find derivation, this must have been an extremely difficult case for the panel.

VIII. THE *35 USC 135*(B) BAR

Nothing relevant this year.

IX. CORROBORATION

A. REASONABLE DILIGENCE IS A TOUGH STANDARD!

1. Anderson v. Hill

Reading ***Anderson v. Hill, 66 USPQ2d 1113 (PTOBPAI 2002)*** (non-precedential) (opinion delivered by APJ Medley for a panel that also consisted of APJs Schafer and Lee), should be a required and chastening experience for anyone tasked with preparing 37 CFR 1.672(b) declarations seeking to establish reasonable diligence extending from just prior to an adversary's "entry into the field" until one's client's actual or constructive reduction to practice date. Reasonable diligence is a tough standard, and most attempts to establish reasonable diligence are unsuccessful--either because the client wasn't, in fact, reasonably diligent as seen by the APJs or because the hapless attorney or agent tasked with proving reasonable diligence failed to prove what the client actually did.

Anderson v. Hill, doesn't establish any new law on diligence. It is, however, a useful collection of basic principles.

(1) "To satisfy the reasonable diligence requirement, the work relied on must ordinarily be directly related to reduction to practice of the invention of the count at issue. *Naber v. Cricchi, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977).*" n23

[*472] "The difficulty with Anderson's diligence case is that there is no demonstration, supported by sufficient evidence, that the inventors were performing all of the other tasks [relied on as evidence of diligence] with the goal in mind of reducing the invention to practice." n24

(2) Proving reasonable pre-reduction to practice diligence is much more difficult than proving so-called "Peeler diligence" n25 or post-reduction to practice diligence:

The date of activity that Hill relies on that is prior to 20 October 1992 is 14 September 1992, when a letter was sent to Mr. Pascal, a patent agent, soliciting for a cost estimate for writing a patent application for the Hill invention. Hill directs us to no other evidence of acts of diligence from September 1992 until its application is [sic; was] filed on 29 October 1992.

Hill argues that it is clear that the Hill patent application had to be prepared during the time period between 8 September 1992 and 29 October 1992 (Paper 272 at 42). Hill relies on *Shindelar v. Holdeman, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980)* for the proposition that three months is considered a reasonable amount of time for preparing a patent application.

The facts here are distinguishable form those in *Shindelar.* The issue in *Shindelar* was whether a party had suppressed or concealed the invention after it had reduced the invention to practice. Here, the issue, is diligence towards reducing an invention to practice, not whether an already reduced to practice invention has been concealed or suppressed. Hill has failed to discuss in any meaningful way why *Shindelar* applies to the issue of [pre-reduction to practice] diligence.

Even if *Shindelar* should be considered with respect to the facts in this case, *Shindelar* does not stand for the proposition that three months to prepare an application is per se reasonable, when there is *no evidence* based on the record, to support a three month preparation time. In *Shindelar,* there was evidence of acts towards preparing the application. Here, there are none. n26

(3) Attorney diligence is not self evident or presumed. It must be proved! Hill provides little or no evidence as to what occurred during the period between 14 September 1992 and 29 October 1992. Hill fails to direct us to evidence that would even explain Mr. Pascal's activities.

[*473] Further, while the diligence law permits an attorney to work on his [or her] backlog and related cases, the law also specifies that "the attorney has the burden of keeping good records of the dates when cases are docketed as well as the dates when specific work is done on the applications." *Bey v. Kollonitsch, 806 F.2d at 1028, 231 USPQ at 970.* Here, no dates or records of Mr. Pascal's activities have been offered into evidence. n27

COMMENT

Everybody spends twenty-four hours a day doing something! Merely proving that a witness was hard at work at *something* doesn't prove that he or she was hard at work reducing the invention defined by the count to practice.

X. INTERFERENCE PRACTICE

A. SOMETIMES THE TRIAL SECTION DOES *HANDLE PATENT-PATENT INTERFERENCES AFTER ALL*

1. Anderson v. Hill

In *Louis v. Okada, 57 USPQ2d 1430 (PTOBPAI 2001)* (expanded panel consisting of CAPJ Stoner and *every* then member of the Trial Section), the Trial Section denied Louis's motions to add two Okada patents to the interference without considering Louis's contentions that the claims in those patents were not patentably distinct from the claims of the Okada application in interference on the ground that Louis's case in interference was a patent and that the board does not have jurisdiction over patent-patent interferences. n28 According to the expanded panel's unanimous opinion:

The Board's jurisdiction for declaring and conducting interferences is bottomed on *35 U.S.C. § 135*(a), which states:

> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the **[*474]** Commissioner shall give notice of such declaration to the applicants or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.

Section 135(a) of Title 35, United States Code, does not authorize declaration of a patent versus patent interference. Even Sauer appears to be in agreement with that view. The "opinion" of the Director in *35 U.S.C. § 135*(a) is directed to "an application." What Sauer contends is that where one of the two patents is owned by a party which also has a pending application drawn to the same patentable invention, then the Board has jurisdiction to declare an interference involving the two patents and the application--*i.e.,* one patent and an application of one party, on one side, versus one patent of another party, on the other side. Sauer contends that if an application from either party is in the picture, the

situation is not a patent versus patent interference and thus the Board has jurisdiction under *35 U.S.C. § 135*(a) to declare and conduct an interference.

Sauer's position is based on an erroneous view of § 135(a) interferences as a means to solve all conflicts between parties with respect to an invention *rather* than an administrative tool for the Patent and Trademark Office to decide whether to issue an application as a patent. The conflict between parties, insofar as any interference proceeding in the Patent and Trademark Office is concerned, arises solely because one or more applications *or* patents stands in the way of the issuance of an application under examination. As we have mentioned above, the "opinion" of the Director, as is referred to in *35 U.S.C. § 135*(a), is directed to "an application." n29

In our view the Board is without jurisdiction under *35 U.S.C. § 135*(a) to adjudicate a conflict between two issued patents. That is so no matter how far the parties have developed the issues, how much special expertise the members of the Board may have in determining them, or how quickly and inexpensively the Board may determine the issues as compared to a U.S. District Court in an action under *35 U.S.C. § 291*. n30 Even if both parties as well as the Board desire to have a conflict between patents adjudicated by the Board, the Board is without power to do so. Congress imposed these restrictions on our jurisdiction in interferences. n31

[*475] However, ***Anderson v. Hill, 66 USPQ2d 1113 (PTOBPAI 2002)*** (non-precedential) (opinion delivered by APJ Medley for a panel that also consisted of APJs Schafer and Lee), which was a three-party interference, was just such a patent-patent interference. The parties Anderson and Hill were both in the interference on patents; only the party Snitzer was in the interference on an application. Nevertheless, the panel (every member of which was on the panel that decided *Louis v. Okada* and one member of which delivered the opinion in *Louis v. Okada*) handled the interference without commenting on whether or not it had jurisdiction to do so.

The only possible distinction between *Anderson v. Hill* and *Louis v. Okada* is that *Anderson v. Hill* was a three-party interference, whereas *Louis v. Okada* was a two-party interference. However, in *Louis v. Okada* the panel stated that:

A conflict between two patents is no less a conflict between two patents simply because another conflict exists between one of the patents and a separate application. Under *35 U.S.C. § 135*(a), the Board is without jurisdictions to adjudicate a conflict between two patents[,] and that is unchanged by having another conflict, one between an application and one of the conflicting patents, in the same mixing bowl. n32

The panel's opinion in *Louis v. Okada* suggests that indeed the fact that *Anderson v. Hill* involved three different real-parties-in-interest, whereas *Louis v. Okada* involved only two different real-parties-in-interest, justifies a different result:

In *Wilson v. Yakel, 1876 Dec. Comm'r. Pat. 245* (Comm'r. Pat. 1876), a single application of Wilson interfered with a patent of Yakel and also with a patent of Rogers. The Commissioner sanctioned an interference proceeding involving all three parties, which in effect represented a merger of two underlying interferences each involving the applicant Wilson and a patentee. In this case between junior party Sauer and senior party Kanzaki, only one of the multiple underlying interferences would be between an application and a patentee. The other one(s) would be between Kanzaki as a patentee and Sauer as a patentee. The 1984 Notice of Final Rule Making made clear that even in the sanctioned circumstance of *Wilson v. Yakel, supra,* if the applicant drops out for whatever reason, the **[*476]** interference would have to be terminated between the remaining patentees for lack of subject matter jurisdiction. n33

COMMENT

I submit that the panel in *Louis v. Okada* was cutting the baloney unreasonably thin. It is no doubt true that *if* the only party involved in a three real-parties-in-interest interference on an application (Snitzer in *Anderson v. Hill*) dropped out of the interference, the Board would have to terminate the interference for lack of subject matter jurisdiction under the current, lamentably narrow version of *35 USC 135*(a). However, causing a substantive, socially undesirable result to turn on a highly unlikely possibility is no way to run a railroad--or an interference system! n34

B. THE FEDERAL CIRCUIT APPROVES THE TWO-WAY TEST FOR INTERFERING SUBJECT MATTER

1. Eli Lilly & Co. v. Board of Regents of the University of Washington

In *Eli Lilly & Co. v. Board of Regents of the University of Washington, 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003)* (opinion of the Court delivered by Circuit Judge Gajarsa and joined by Circuit Judge Michel; dissenting opinion delivered by Circuit Judge Lourie), n35 the Court approved the two-way test for interfering subject matter enunciated by the Trial Section in *Winter v. Fujita, 53 USPQ2d 1234 (PTOBPAI 1999)* (expanded panel; opinion by SAPJ McKelvey). According to the majority, the Trial Section's "interpretation of 37 C.F.R. § 1.601(n) as establishing a two-way test for determining whether two parties are claiming the 'same patentable invention' is neither plainly erroneous nor inconsistent with the language of the regulation...." n36 According to the dissent, "the Board's action constitutes an abuse of discretion because the language of Rule 601(n) plainly describes a one-way test and does not support a two-way test. While Winter does hold that a two-way test is appropriate, its conclusion, not binding on us, is unsupported by any reasoning." n37

[*477] 37 CFR 1.601(n) reads as follows:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as *(35 U.S.C. 102)* or is obvious *(35 U.S.C. 103)* in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new *(35 U.S.C. 102)* and non-obvious *(35 U.S.C. 103)* in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Also relevant here are 37 CFR 1.633(b), which reads as follows:

A motion for judgment on the ground that there is no interference-in-fact. A motion under this paragraph is proper only if the interference involves a design application or patent or a plant application or patent or no claim of a party which corresponds to a count is identical to any claim of an opponent which corresponds to that count. See § 1.637(a). When claims of different parties are presented in "means plus function" format, it may be possible for the claims of the different parties not to define the same patentable invention even though the claims contain the same literal wording.

and 37 CFR 1.601(j), which reads as follows:

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

During the preliminary motions period, UW filed a 37 CFR 1.633(b) motion for a judgment that there was no interference-in-fact, a panel of the Trial Section consisting of APJs Schafer, Torczon, and Tierney (opinion by APJ Tierney) granted that motion, and this appeal was from that decision. n38 Interestingly, the Solicitor filed an amicus curiae brief supporting UW's and the Trial Section's interpretation of 37 CFR 1.601(n).

[*478] According to the majority's opinion:

This case presents the question of whether the Director's two-way test n39 for determining whether two parties claim the "same patentable invention" reflects a permissible reading of 37 C.F.R. § 1.601(n), promulgated pursuant to *35 U.S.C. § 135*(a), where a species claim to a presumptive senior party allegedly anticipates a genus claim to a presumptive junior party. n40

Section 135 of the United States Code, Title 35, governs patent interference proceedings, which are designed to determine whether two patent applications (or a patent application and an issued patent) are drawn to the "same patentable invention" and, if so, which of the competing parties was first to invent the duplicative subject matter. *See Conservolite, Inc. v. Widmayer, 21 F.3d 1098, 1100-01 [30 USPQ2d 1626]* (Fed. Cir. 1994). The statutory basis for declaring an interference proceeding, *35 U.S.C. § 135*(a), reads in pertinent part:

> Whenever an application is made for a patent which, *in the opinion of the Director,* would interfere with any pending application, or with any unexpired patent, an interference may be declared... The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.

35 U.S.C. § 135(a) (2000) (emphases added [by the Court]). The plain meaning of this statute demonstrates that Congress has expressly indicated its preference that the declaration of an interference pursuant to § 135 be discretionary. *Burton v. Adang, 162 F.3d 1140, 1144 [49 USPQ2d 1128]* (Fed. Cir. 1998) ("The plain meaning of this statute is clear from the use of the permissive term 'may' that the [Director] has discretion whether to declare an interference."); *see also In re Alappat, 33 F.3d 1526, 1531 [31 USPQ2d 1545]* (Fed. Cir. 1994) (*en banc*) ("When statutory interpretation is at issue, the plain and unambiguous meaning of a statute prevails in the absence of clearly expressed legislative intent to the contrary.") Section 135(a) states that the Board shall determine questions of priority once an interference proceeding is declared. This authority for the Board to determine questions of priority, however, does not vitiate the Director's discretion to begin or discontinue an interference once declared. *See 35 U.S.C. § 135*(a). Accordingly, **[*479]** the mandatory language only instructs the Board of its jurisdiction over an active interference. *See id.* n41

The majority concluded that the Trial Section's interpretation of 37 CFR 1.601(n), while "under-inclusive because it concludes there is no interference-in-fact even if an interference proceeding would have led to the conclusion that the species was invented before the genus," n42 was "textually defensible" n43 and "at least as plausible as competing...[interpretations n44 of 37 CFR 1.601(n)]." n45 According to the majority:

the one-way test is over-inclusive because it concludes there is an interference-in-fact even if an interference proceeding would have led to the conclusion that the genus was invented before, and separately patentable from, the species. Section 1.601(n) reasonably can be interpreted to require an election between either a one-way or a two-way test. The Director has reasonably opted for a two-way test to avoid subjecting broad patents for basic inventions to interferences, some of which would have been unnecessary. To read the regulation, as Lilly and our colleague in dissent urge, to require the continuance of an interference proceeding where a genus claim to a presumptive junior party is allegedly anticipated by a species claim to a presumptive senior party, is a plausible alternative reading, but a reading which in the Director's discretion he has chosen not to accept. n46

According to the dissent:

In each case [i.e., in each sentence in 37 CFR 1.601(n)], a one-way test is set forth: whether invention A is the same as or is obvious with respect to invention B, *assuming B is prior art with respect to A.* The rule does not require that B be the same as or obvious with respect to A, or assume that A is prior art with respect to B. Thus, the rule provides a one-way test, not a two-way test, as the Board erroneously held. n47

[*480] Applying the one-way test clearly set forth by Rule 601(n), UW's generic claim 1 must be held to be the same patentable invention, not because a genus and a species are the same, but because Rule 601(n) refers to *35 U.S.C. § 102* after its reference to "same invention," and thereby indicates that the phrase "same patentable invention" encompasses the concept of "is anticipated by." Lilly, on the present record, would be the senior party were an interference to be declared. n48 Clearly, the species in Lilly's prior filed claims anticipates UW's later-filed generic claim. If an interference were to be declared, UW might antedate Lilly's claim, in which case UW's generic claim would remain in force. In that case, however, Lilly's species claim would also remain, because the Board already found the species to be a separate patentable invention with respect to the prior genus. The interference will seem to have been conducted in vain, but the issues will have been settled in accordance with the statutory procedure for resolving a possible conflict of priority between an application (albeit a reissue application) and a patent. If UW does not antedate Lilly's species, then UW's generic claim will be invalid under *35 U.S.C. 102*(g), and the matter will have been settled by the optimal tribunal. n49

COMMENTS

Most of us think that we are over-worked and under-paid. However, it is part of the Federal Circuit's task to keep the PTO's nose to the grindstone.

What the majority's decision does is to approve the board's latest labor-saving stratagem. In the interference context, the Federal Circuit has twice rejected such labor-saving stratagems in recent years--to the general approbation of the interference bar.

The board's first labor-saving stratagem was to hold that an interferent's filing of a 37 CFR 1.633(a) motion attacking the patentability of an opponent's claim designated as corresponding to the or a count over the prior art was a bind-

ing admission that the interferent's claim or claims designated as corresponding to that count were unpatentable over the prior art. *Guglielmino v. Winkler, 11 USPQ2d 1389 (PTOBPAI 1989).* The Federal Circuit overruled that labor-saving stratagem in *Winkler v. Guglielmino, 17 USPQ2d 1175 (Fed. Cir. 1990)* (per curiam) (non-precedential). The Federal Circuit's opinion was, unfortunately, non-precedential. However, the Court's holding fortunately led to a Commissioner's Notice published at *1118 OG 19* **[*481]** (Sept. 11, 1990) that required the board to abandon that labor-saving stratagem.

The board's second labor-saving stratagem was to hold that, if a count is unpatentable over the prior art, all claims designated as corresponding to that count are unpatentable over that prior art. The Federal Circuit overruled that labor-saving stratagem in *In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993),* which held that the patentability of the claims designated as corresponding to the or a count must be determined on a claim-by-claim basis.

This is the board's third, conceptually similar labor-saving stratagem. Its origin, as previously pointed out, is *Winter v. Fujita, 53 USPQ2d 1234 (PTOPBAI 1999) (expanded panel), 53 USPQ2d 1478 (PTOBPAI 2000)* (expanded panel)--so it is *not* a "long-standing...test," as erroneously stated by the majority. n50 Presumably what the majority meant was that 37 CFR 1.601(n) is, relatively speaking, long-standing. However, 37 CFR 1.601(n) does not set forth a two-way test. Rather, the *Trial Section* created the two-way test out of whole cloth in *Winter v. Fujita*--and, as the dissent correctly noted, the Trial Section's holding in *Winter v. Fujita* is "unsupported by any reasoning." n51

I am not entirely unsympathetic to the Trial Section's efforts to avoid unnecessary or socially unproductive labor. However, the problem with the Trial Section's latest labor-saving stratagem is that the labor that it is attempting to avoid is neither unnecessary nor socially unproductive. A simple Venn diagram will illustrate why.

Assume that the commercially important product (called P in the Venn diagram below) is encompassed by *both* parties' claims designated as corresponding to the count. This very common situation can be illustrated as follows:

[SEE ILLUSTRATION IN ORIGINAL]

[*482] What that means is:

1. The owner of the subgeneric claim cannot safely commercialize P without paying for a license from the owner of the generic claim;

2. The owner of the generic claim cannot safely commercialize P without paying for a license from the owner of the subgeneric claim; and

3. Third parties cannot safely commercialize P without paying for a license from *both* the owner of the generic claim *and* the owner of the subgeneric claim because both could sue it for patent infringement--perhaps in different courts! n52

Of course, if the assignee of the subgeneric claim really did make its invention before the assignee of the generic claim (as Lilly alleges was the case here), the generic claim is invalid or unpatentable, depending on whether it is in a patent or in an application. However, the majority in effect said, "Don't worry about that. The district courts will take care of that."

The problem with the majority's reasoning, from the perspective of the users of the interference system, is twofold.

First, for a variety of reasons that I will not go into here in detail because of the space limitation, it costs approximately ten times as much to "take down" a claim in infringement litigation as it costs to "take down" a claim in an interference. n53

Second, a company concerned by a situation such as this (and, perhaps, hesitating to start or continue a multi-million dollar project because of that concern) cannot even bring a declaratory judgment action to deal with that concern unless it has been placed in justifiable apprehension of being sued for patent infringement--a situation that it will not be in unless it commits the resources to bring the product to market. In sharp contrast, all that such a company needs to provoke an interference is an application containing an interfering claim to which it is entitled but for the existence of the prospective interference.

Hence, the majority's holding is *not* a "victimless crime." It has appalling real-world consequences.

[*483] *C. THE BOARD HAS TOTAL DISCRETION TO IGNORE THE "RULE" THAT REDIRECT MUST BE WITHIN THE SCOPE OF THE CROSS*

1. Taskett v. Dentlinger

In *Taskett v. Dentlinger, 344 F.3d 1337, 68 USPQ2d 1472 (Fed. Cir. 2003)* (opinion by Circuit Judge Michel for a panel that also consisted of Circuit Judges Dyk and Prost), the court held that the board had discretion to consider evidence elicited on re-direct despite Taskett's argument that Dentlinger's re-direct exceeded the scope of its cross-examination. The board had denied Taskett's motion to strike the redirect on the ground that, "even if it exceeded the scope of cross-examination, the re-direct examination was proper because its purpose was 'to bring out additional facts and circumstances concerning the invention'." n54 On appeal, the court affirmed, saying:

we conclude that the Board did not abuse its discretion. The Board has ample authority and discretion to admit relevant testimony of the kind given by Landa. We think it unclear that anything that Landa said on re-direct was, as argued, beyond the scope of the cross-examination. But[,] even if it were, it was entirely appropriate for the Board to admit it anyway in order to clarify facts that were not made sufficiently clear by either cross-examination or direct examination, as the Federal Rules of Evidence, and thus the Board's Rules, so permit. *See* 37 C.F.R. § 1.671(b) n55; Fed. R. Evid. 611(b). n56, n57

COMMENT

This was a pre-Trial Section interference. It is difficult to imagine any member of the Trial Section so holding. n58

[*484] Moreover, if the board could let in Landa's testimony on re-direct on this ground, is there *anything* to the "Rule" that re-direct must be within the scope of cross?

D. FAILURE TO CALL AN AVAILABLE CORROBORATING WITNESS CAN LEAD TO SUPPRESSION OF THE CORROBORATING WITNESS'S RECORDS

1. Chen v. Bouchard

In *Chen v. Bouchard, 347 F.3d 1299, 68 USPQ2d 1705 (Fed. Cir. 2003)* (majority opinion by Circuit Judge Lourie, joined by Circuit Judge Schall; opinion dissenting in part by Circuit Judge Newman), a panel of the board had suppressed the records of Dr. Wei, a laboratory technician who had worked for Dr. Chen. Chen argued that "the suppression of ...[Dr. Wei's records] was unreasonable, because...the suppressed exhibits had been authenticated...." n59 The majority disagreed:

We agree with Bouchard that Chen has failed to demonstrate that the Board abused its discretion in its evidentiary rulings. The Board took particular note of the fact that Wei, the author of the notebooks, was not called to testify. The Board also properly concluded, on the basis of its quite thorough analysis, that Wei's notebooks do not fall within the "business records" exception<2> or the "catchall" exception<3> to the hearsay rule. *** While notebook records are obviously of prime importance in proving the elements of invention, the failure of the notebooks' alleged author to testify; the fact that it was not established on the record that those notebooks were actually the notebooks of Wei, except by the circular testimony of Chen, whose activity was what was intended to be corroborated by the notebooks; and the lack of evidence of Bristol-Myers Squibb's policies regarding maintenance of laboratory notebooks, all compel affirmance of the Board's decision to exclude the notebooks, under our abuse of discretion standard. We therefore affirm the Board's evidentiary rulings. n60

<2> The so-called "business records" exception to the hearsay rule, Fed. R. Evid. 803(6), at all times relevant to this interference, read as follows:

> The following are not excluded by the hearsay rule, even though the declarant is available as a witness:...
>
> [*485] (6) Records of regularly conducted activity. A memorandum, report, record, or data compilation, in any form, of acts, events, conditions, opinions, or diagnoses, made at or near the time by, or from information transmitted by, a person with knowledge, if kept in the course of a regularly conducted business activity, and if it was the regular practice of that business activity to make the memorandum, report,

> record, or data compilation, all as shown by the testimony of the custodian or other qualified witness, unless the source of information or the method or circumstances of preparation indicate lack of trustworthiness.

Because Chen presented no testimony from the "custodian or other qualified witness" that Wei's notebooks were "records of regularly conducted activity," relying instead only on Chen's uncorroborated testimony, the Board properly concluded that those notebooks did not fall within the purview of the exception.

<3> In relevant part, the "catch-all" exception, Fed. R. Evid. 807, reads as follows:

> A statement not specifically covered by Rule 803 or 804 but having equivalent circumstantial guarantees of trustworthiness, is not excluded by the hearsay rule...

Because the Board found that Chen offered no evidence of the "circumstantial guarantees of trustworthiness" other than the very documents of Wei that Bouchard sought to exclude, the Board properly concluded that those documents also do not fall within this exception.

Judge Newman (who, like Judge Lourie, is a Ph.D. in chemistry and was chief patent counsel at a major research company before her elevation to the bench) dissented as to this issue:

Chen's conception of the cyclopropataxol of the counts, and the extensive documentary and testimonial evidence of its synthesis, identification, analysis, and biological activity, were presented and documented in a straightforward manner, in accordance with standard laboratory practices and scientific protocols. The Board abused its discretion in refusing to admit the research notebooks of Chen's assistant Jianmei Wei. The Board excluded the notebooks on the basis that they were hearsay and not within the business records exception to the hearsay rule. The Board held, citing Fed. R. Evid. 803(6), that Chen was required to prove that the notebooks were

> made at or near the time by, or from information transmitted by, a person with knowledge, if kept in the course of regularly conducted business activity, and if it was the regular practice of that business activity to **[*486]** make the memorandum, report, record or data compilation, all as shown by *the testimony of the custodian or other qualified witness,* unless the source of information or the method or circumstances of preparation indicate lack of trustworthiness.

Board Op. at 52 (emphasis by the Board). There can be no dispute that Chen satisfies the criteria of a "qualified witness," under Rule 803(6), or that it was the regular practice to keep research notebooks. *See Air Land Forwarders, Inc. v. United States, 172 F.3d 1338, 1344 (Fed. Cir. 1999)* (where additional guarantees of reliability were present, the business records "were properly admitted by the trial court even though the government did not produce a witness that could testify with first-hand knowledge as to the procedures used in the original preparation of each of the repair estimates"); *Conoco v. Department of Energy, 99 F.3d 387, 391 (Fed. Cir. 1996)* ("Courts have made clear, however, that the 'custodian or other qualified witness' who must authenticate business records need not be the person who prepared or maintained the records, or even an employee of the record-keeping entity, as long as the witness understands the system used to prepare the records."). Chen testified that the notebooks were those of Ms. Wei, n61 that he supervised her work and reviewed the notebooks, and that the information sought to be admitted was timely recorded. The Board erred in refusing to consider Chen's testimony on the ground that it was not corroborated. Not every aspect of an inventor's testimony requires corroboration. n62

COMMENT

Obviously, if Dr. Wei's records were to be considered, Bouchard's counsel needed the opportunity to cross-examine her! That he or she had the opportunity to cross-examine Dr. Chen was no substitute for having the opportunity to cross-examine the technician who actually did the work. Hence, I applaud the majority's ruling.

E. MUST AN EXPERT WITNESS'S OPINIONS BE "SUPPORTED BY CITED LITERATURE"?

1. Velander v. Garner

Velander v. Garner, 348 F.3d 1359, 68 USPQ2d 1769 (Fed. Cir. 2003) (opinion by Circuit Judge Schall joined by Circuit Judge Prost; dissenting opinion by Circuit Judge Gajarsa n63), apparently approves a **[*487]** panel of the BPAI's n64 having given no weight to the opinions of the expert witnesses of *either* of the parties because those opinions were not "supported by cited literature." However, the panel of the BPAI then went on to grant the motion of the party whose expert witness it had denigrated (based on the expert opinions of the APJs), and the panel of the CAFC approved that, too.

Garner filed a 37 CFR 1.633(a) motion for a judgment that Velander's claims were unpatentable over certain prior art and conceded, pursuant to 37 CFR 1.637(a), n65 that, if Velander's claims designated as corresponding to the count were unpatentable, so were Garner's claims designated as corresponding to the count. Garner filed a 37 CFR 1.639(b) declaration from an expert witness in support of that motion, and Velander filed three 37 CFR 1.639(b) declarations from expert witnesses in support of its opposition to that motion. It was common ground that all of the elements recited in both parties' claims designated as corresponding to the count were in the prior art. The key question was whether a person of ordinary skill in the art as of the critical date would have had "a reasonable expectation of success" in combining those elements to obtain the claimed invention. Garner's expert said that such a person would have had such an expectation, and Velander's experts said that such a person would not have had such an expectation.

The panel of the board "cautioned...that the...testimony [of Garner's expert witness] was to be accorded little weight, except where it was supported by cited literature" n66 and "performed a similar analysis with respect to the declarations of Velander's experts...." n67 In particular, "The [panel of the] Board considered, but then discounted, Dr. Rosen's **[*488]** testimony about a lack of reasonable expectation of success because he did not explain how the references that he cited...supported his opinion that a skilled worker would not have expected to succeed." n68

Notwithstanding its denigration of the testimony of *all* of the expert witnesses, the panel of the BPAI granted Garner's motion (based primarily on its own analysis of the cited references n69) and entered judgment that *all* of the claims of both parties designated as corresponding to the count were unpatentable.

On appeal, a panel of the Federal Circuit affirmed. The linchpin of its affirmance was, as is so often the case, its standard of review:

On appeal, we review the Board's ultimate conclusion of obviousness without deference, while we review the Board's underlying factual determinations for substantial evidence. *In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000).* n70

Understandably, Velander directs our attention to the evidence in the record that discusses the difficulties in transgenic expression of complex proteins like fibrinogen. Such material arguably supports a conclusion contrary to the one reached by the Board. At the same time, other evidence in the record supports the conclusion reached by the Board. If the evidence will support several reasonable but contradictory conclusions, we will not find the Board's decision unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative. *Jolly, 308 F.3d at 1320.* That is the case here. In other words, in this complex case, it is not for us to second-guess the Board's assessment of the evidence. Our task is to determine whether substantial evidence supports the conclusion chosen by the Board. We hold that substantial evidence supports the Board's conclusion that Garner established by a preponderance of the evidence that, as of February 18, 1993, one of ordinary skill in the art would have believed that there was a reasonable expectation of producing a recoverable amount of biologically active fibrinogen by successfully generating a "transgenic non-human female mammal that produces recoverable amounts of biologically active human fibrinogen...in its milk." n71

[*489] *COMMENTS*

I am concerned by the sweeping statements of the panel of the board that the testimony of the expert witnesses "was to be accorded little weight, except where it was supported by cited literature." Sometimes there *is* no citable literature that is directly on point! I have no trouble with saying that mere conclusory statements of expert witnesses are entitled to little weight. However, sometimes all that an expert witness can do is reason from general principles. Some-

times such reasoning is persuasive, and sometimes it isn't. However, there is nothing wrong with reliance on such evidence!

Moreover, the panel of the board did not really rely on "the evidence" (i.e., the cited literature) so much as on its own assessment of the inferences to be drawn from that literature. That is, having decided to give "little weight" to the inferences drawn from the cited literature by the parties' expert witnesses (and there was apparently no dispute that those witnesses *were* experts in the relevant field), the APJs then proceeded to give great weight to their own assessment of the inferences to be drawn from that literature! While the APJs may, in general, be better suited to that task than the average Article III judge, I question whether they were really better suited to that task than the parties' expert witnesses.

XI. PATENTABILITY ISSUES ARISING IN AN INTERFERENCE CONTEXT

A. THE HALLIBURTON REJECTION IS ALIVE AND WELL IN THE TRIAL SECTION

1. Sanada v. Reynolds

In *Sanada v. Reynolds, 67 USPQ2d 1459 (PTOBPAI 2003)* (non-precedential) (opinion delivered by APJ Lee for a panel that also consisted of CAPJ Stoner and APJ Barrett) n72, a panel of the Trial Section ruled that the *Halliburton* rejection lives on except to the limited extent that it has been statutorily overruled by what is now the sixth paragraph of *35 USC 112:*

In our view, under the Supreme Court's decision in *Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1, 71 USPQ 175 (1946),* there is a judicially created "dead **[*490]** zone" for claims using purely functional language to define a structural component. An exception exists only when such language is regarded as a means-plus-function clause under *35 U.S.C. § 112,* last paragraph and narrowly construed under the same. n73

In the case before it, the question was whether the odd language employed by Reynolds's counsel was entitled to the benefit of the sixth paragraph of *35 USC 112.* In what must be regarded as a bit of polite legal fiction, the panel said that:

The guideline provided by the Court of Appeals for the Federal Circuit on when to treat a certain claim language as means-plus-function recitation under *35 U.S.C. § 112,* last paragraph, is clear. Use of the word "means" creates a presumption that § 112, sixth paragraph, applies. *Personalized Media Communications LLC v. ITC, 161 F.3d 696, 703, 48 USPQ2d 1880, 1886 (Fed. Cir. 1998).* Failure to use the word "means" creates a presumption that § 112, sixth paragraph, does not apply, *Id., 161 F.3d at 703-704, 48 USPQ2d at 1887.* But the presumptions can be rebutted. The Federal Circuit stated:

> These presumptions can be rebutted if the evidence intrinsic to the patent and any relevant extrinsic evidence so warrants. [Footnote omitted. [by the Court]] n74

Surprisingly, the panel found that the presumption *had* been rebutted despite the fact that Reynolds's counsel submitted no evidence but instead merely submitted a paper stating:

In response to the show cause order dated February 20, 2003, it is submitted that the recitation in claim 7 of "a destroying member for destroying said thermally processed film after said film has been scanned" should be regarded as a means-plus function recitation under *35 U.S.C. § 112,* sixth paragraph. As explained on page 6 of the Show Cause Order [sic[added by the panel]], it is recognized that failure to use the word "means" creates a presumption that 112, sixth paragraph does not apply but the presumption can be rebutted. It is noted that the term "a destroying member" in claim 7 is provided within the context of functional language to describe the feature of destroying the thermally processed film after the film has been scanned. That is, it is submitted that the functional claim language of claim 7 with respect to "a destroying member" is permissible under the conditions of *35 U.S.C. 112,* **[*491]** sixth paragraph and thus, Applicants are entitled to the corresponding structure, material or acts disclosed in the specification and equivalents thereof. n75

COMMENT

Apparently, non-traditional (and non-statutorily sanctioned) language is to be treated (at least by the Trial Section) as the equivalent of means-plus-function language if counsel for the party using that language says that it should be!

XII. COURT REVIEW OF DECISIONS IN INTERFERENCES

Nothing relevant this year.

XIII. POST INTERFERENCE PRACTICE

Nothing relevant this year.

XIV. RELATIONSHIP OF INTERFERENCE PROCEEDINGS TO COURT PROCEEDINGS

A. A PENDING *35 USC 291* PATENT-PATENT INTERFERENCE DOES NOT PRECLUDE AN APJ FROM DECLARING A *35 USC 135*(A) INTERFERENCE

1. Stampa v. Jackson

In *Stampa v. Jackson, 65 USPQ2d 1942* (Tierney, APJ, not joined by any other APJ, 2002) (non-precedential), APJ Tierney declared a *35 USC 135*(a) n76 interference (1) despite the pendency of a *35 USC 291* n77 **[*492]** interference between the same two real parties in interest involving the same claims (as well as additional claims in the *35 USC 135*(a) interference) and (2) despite the fact that the Article III district court judge had held that there was no interference in fact! n78

The party (Jackson) that had won on the interference-in-fact issue in the district court argued that the district court's ruling "had a preclusive effect upon the declaration of an interference by the United States Patent & Trademark Office." n79 Judge Tierney disagreed, citing *Musco Corp. v. United States, 303 F.3d 1316, 1329, 64 USPQ2d 1182, 1190 (Fed. Cir. 2002),* and *In re Freeman, 30 F.3d 1459, 1465, 31 USPQ2d 1444, 1448 (Fed. Cir. 1994),* for the proposition that:

Issue preclusion is appropriate only when the following four elements are satisfied:

(1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the first action; and (4) plaintiff had a full and fair opportunity to litigate the issue in the first action. n80

According to Judge Tierney, the prior decision by the Article III judge did not qualify for issue preclusion effect for two different reasons: the interference-in-fact issues in the two proceedings were not identical n81 and the decision by the district court was not final because it was on appeal.

[*493] As to the first ground, Judge Tierney stated that:

Under *35 U.S.C. § 135*(a), an interference may be declared whenever an application is made for a patent, which, in the opinion of the Director, would interfere with any pending application or any unexpired patent. n82

As the Director's opinion regarding the existence of an interference is not an issue in a § 291 proceeding, the two proceedings raise different issues. n83

As to the second ground, Judge Tierney stated that:

For a judgment to be "final" for purposes of issue preclusion, "the decision need only be immune, as a pratical matter, to reversal or amendment." *Vardon Golf Company, Inc. v. Karsten Manufacturing Corporation, 294 F.3d 1330, 1333, 63 USPQ2d 1468, 1670 (Fed. Cir. 2002).* The district court's decision is presently on appeal. As such, there is no issue preclusion as the district court's decision is not immune to reversal or amendment. n84

COMMENTS

It is certainly true that *the language* of *35 USC 135*(a) and *35 USC 291* is different. However, it strikes me that Judge Tierney's reliance on the fact that *35 USC 291* does not make the Director's opinion a factor in deciding whether

or not an interference-in-fact exists is cutting the baloney extremely thin. n85 Perhaps he would have done better to [*494] forthrightly assert that the *substantive* standards for finding the existence of an interference-in-fact appear to be different in the two types of proceedings. n86

Finally, reading Judge Tierney's opinion I get the definite feeling that the *real* basis for Judge Tierney's holding is that he thought that the district court's holding was egregiously erroneous. If my feeling is correct, then the Federal Circuit's opinion in *Medichem S.A. v. Rolabo S.L.*, discussed below, strongly supports that basis.

B. 35 USC 135(a) INTERFERENCES ARE PREFERABLE TO 35 USC 291 PATENT-PATENT INTERFERENCES AS A CONSEQUENCE OF THE BOARD'S EXPERTISE IN INTERFERENCE MATTERS

1. Medichem S.A. v. Rolabo S.L.

In *Medichem S.A. v. Rolabo S.L., 353 F.3d 928, 69 USPQ2d 1283 (Fed. Cir. 2003)* (opinion of the Court delivered by Circuit Judge Gajarsa and joined by Circuit Judge Clevenger and Circuit Judge Dyk), the Court found that the district court for the Southern District of New York erred (i) in its application of the two-way obviousness test for determining whether an interference-in-fact existed and (ii) by determining priority prior to engaging in the interference-in-fact analysis.

Regarding the district court's premature determination of priority, the Court stated:

'Interference between patents is a sine qua non of an action under § 291.' [*Albert v. Kevex Corp., 729 F.2d 757, 760-761, 220 USPQ 202 (Fed. Cir. 1984)].* Without first identifying an interference-in-fact under the two-way test, a court has no jurisdiction [*495] to make a priority determination between two patents under § 291. [Id.] This jurisdictional limitation on a court's power has significant import where, as here, the district court ultimately finds no interference-in-fact. While the district court is free to reach the same conclusion on remand, it may do so only once proper jurisdiction--an interference-in-fact--has been established. n87

Because the Court found that the district court erred in its application of the two-way obviousness test, the Court vacated the district court's priority determination and remanded the case for further proceedings.

In view of a related *35 USC 135*(a) proceeding before the Board in Stampa v. Jackson, n88 the Court suggested to the district court that:

Although proceedings in the PTO under § 135 and proceedings in a district court under § 291 are not identical, they are closely related. The Board has already declared an interference-in-fact. [*Stampa v. Jackson, 65 USPQ2d 1942 (BPAI 2003).]* While the issues of interference before the Board may, as pointed out by the Board itself, differ from those in front of the district court, the Board's resolution of the matter will certainly aid the district court in subsequent proceedings. See *Fisher Controls Co. v. Control Components, Inc., 443 F.Supp. 581, 582, 196 USPQ 817 (S.D. Iowa 1977).* The record generated by the Board, particularly in light of the Board's expertise in the matter, may permit the district court to avoid a needless duplication of efforts. n89

COMMENT

35 USC 291 interferences are to be avoided if at all possible. District court judges struggle with traditional patent law issues such as infringement and claim construction. Interference matters are even more obscure than issues of that nature and should be placed before the Board by filing a reissue application, if possible, in order to give the PTO jurisdiction.

While the court's opinion stated that:

The discretion to stay proceedings pending the outcome of the PTO proceedings remains available to the district court, and the district court should in no way view our remand as suggesting otherwise, n90 the opinion's conclusion stated that "[we] [*496] remand with an order to stay further proceedings pending the outcome of the interference proceedings involving the '659 Reissue." n91

That order certainly seems, to say the very least, to suggest otherwise.

XV. CONCLUSION

The Federal Circuit's decision in *Eli Lilly & Co. v. Board of Regents of the University of Washington* approving the two-way obviousness test for determining whether an interference-in-fact exists overshadowed all of the other interference related opinions in 2003. It appears that the PTO's trend of declaring fewer interferences using its "discretionary" powers will continue unless addressed by Congress.

FOOTNOTES:

n1 Copyright 2004 by Charles L. Gholz; Oblon, Spivak, McClelland, Maier, & Neustadt, P.C.; Alexandria, Virginia. I acknowledge with thanks the contributions of my colleagues, former Administrative Patent Judge Alton D. Rollins and W. Todd Baker.

n2 Partner in and head of the interference section of Oblon, Spivak, McClelland, Maier & Neustadt, PC.; Alexandria. Virginia. My direct dial telephone number is (703) 412-6485, and my E-mail address is CGHOLZ@OBLON.COM

n3 Federal Circuit Rule 47.8 divides the opinions and orders of the court into those that are "precedential" (i.e., those that may be cited to the court as precedent) and those that are "non-precedential" (i.e., those that may not be cited to the court as precedent). The non-precedential opinions were formerly called "unpublished" opinions, but the court changed its terminology after noting that many of its "unpublished" opinions were in fact published in the United States Patents Quarterly.

The Federal Circuit attempts to discourage citation of its non-precedential opinions to its "feeder" courts and agencies. See, e.g., *Hamilton v. Brown, 39 F.3d 1574 (Fed. Cir. 1994).* However, the non-precedential opinions of the Federal Circuit have at least the same status as law review articles written by the judges of the Federal Circuit, and in practice some of the non-Trial Section administrative patent judges seem to welcome citation of the non-precedential opinions of the Federal Circuit. After all, what the court did once gives at least some guidance to what the court might do again, and the administrative patent judges can use language out of the non-precedential opinions even if they cannot cite them. On the other hand, section 14 of the Trial Section's "STANDING ORDER" says that "Non-precedential decisions of federal courts shall not be cited," but "Non-precedential decisions of the board may be cited, but are not binding." The "STANDING ORDER" gives no explanation for this strange dichotomy.

n4 See also my previous articles at *84 JPTOS 163 (2002), 83 JPTOS 161 (2001), 82 JPTOS 296 (2000), 81 JPTOS 241 (1999), 80 JPTOS 321 (1998), 79 JPTOS 271 (1997), 78 JPTOS 550 (1996), 77 JPTOS 427 (1995), 76 JPTOS 649 (1994), 75 JPTOS 448 (1993), 73 JPTOS 700 (1991), 71 JPTOS 439 (1989),* and *69 JPTOS 657 (1987).*

n5 The fact that I publish this review every year in a similar format accounts for the sections which read in their entirety "Nothing relevant this year."

n6 *344 F.3d at 1338 n. 1, 68 USPQ2d at 1473 n. 1.*

n7 *344 F.3d at 1339, 68 USPQ2d at 1474.*

n8 *344 F.3d at 1339, 68 USPQ2d at 1474.*

n9 *344 F.3d at 1342, 68 USPQ2d at 1476,* citing *Scott v. Finney, 34 F.3d 1058, 1061-63 (Fed. Cir. 1994); Mattor v. Coolegem, 530 F.2d 1391, 1395 (CCPA 1976);* and *Barmag Barmer Maschinenfabric AG v. Murata Mach. Ltd., 731 F.2d 831, 838 (Fed. Cir. 1984).*

n10 *347 F.3d 1299, 68 USPQ2d 1708.*

n11 *347 F.3d at 1299, 68 USPQ2d at 1708.*

n12 See, e.g., *Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975);* and *Weil v. Fritz, 572 F.2d 856, 865-66 n. 16, 196 USPQ 600, 608 n. 16 (CCPA 1978),* which are the opinions most often cited for this proposition. Earlier opinions include *Blodgett v. Richter, 79 F.2d 922, 923-24, 27 USPQ 398, 399-400 (CCPA 1935); Walsh v. Davidson, 101 F.2d 224, 226, 40 USPQ 376, 378 (CCPA 1939);* and *Kyrides v. Anderson, 121 F.2d 514, 516-17, 50 USPQ 131, 132-33 (CCPA 1941).*

n13 And the dissent joined the majority on the issue of Chen's entitlement to the benefit of its priority dates.

n14 I have written this opinion up at much greater length in "How Hard Is It, Really, to Prove Derivation?", 10 Intellectual Property Today No. 12 at page 18 (2003).

n15 ***66 USPQ2d at 1129.***

n16 ***66 USPQ2d at 1128*** ("inventor testimony [rebutting an assertion of derivation] must be corroborated," citing *Cooper v. Goldfarb, 154 F.3d 1321, 1330, 47 USPQ2d 1896, 1903 (Fed. Cir. 1998).*

n17 *Hedgewick v. Akers, 497 F.2d 905, 182 USPQ 167 (CCPA 1974)* (derivation in Austria), and *Asari v. Zilges, 8 USPQ2d 1117 (PTOBPAI 1987)* (derivation in Japan).

n18 *Davis v. Reddy, 620 F.2d 885, 889, 205 USPQ 1065, 1068 (CCPA 1980)* (Rich, J.) ("This 'preponderance of the evidence' burden of proof applies where the issue is derivation."), citing *Mead v. McKiernan, 585 F.2d 504, 507, 199 USPQ 513, 515 (CCPA 1978)* (Rich, J.).

n19 *Spaite v. Marsh, 208 USPQ 145, 154-56 (PTOBPI 1979)* (Champion, El, for a panel that also consisted of Els Calvert and Boler), particularly *208 USPQ at 156* ("It is incumbent upon one to protect his intellectual property, by whatever legal means available, and if he charges someone else with derivation of that property, he has the burden of proving the charge by more than mere suspicious circumstances.").

n20 ***66 USPQ2d at 1129.***

n21 ***66 USPQ2d at 1129.*** The reader interested in the details is referred to the panel's lengthy opinion or to my article in Intellectual Property Today.

n22 ***66 USPQ2d at 1131.***

n23 ***66 USPQ2d at 1122.***

n24 ***66 USPQ2d at 1124.***

n25 So called after *Peeler v. Miller, 535 F.2d 647, 653-54, 190 USPQ 117, 122 (CCPA 1976)* (Rich, J.). See also *Shindelar v. Holdeman, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980);* and *Correge v. Murphy, 705 F.2d 1326, 217 USPQ 753 (Fed. Cir. 1983).*

n26 ***66 USPQ2d at 1125-26.***

n27 ***66 USPQ2d at 1126.*** After I sent counsel for the parties copies of a preliminary draft of this write-up, counsel for Hill called me and explained that his problem was that Mr. Pascal did all his work in Canada prior to December 8, 1993. Given the embarrassing nature of Judge Medley's opinion, it wouldn't have hurt her to point that out in her opinion!

n28 See my write-up of *Louis v. Okada* in Gholz, *A Critique of Recent Opinions of the Federal Circuit in Patent Interferences, 84 JPTOS 163 (2002),* at pages 192-94. In the interest of complete candor, I note that my colleague W. Todd Baker and I represented Louis.

n29 *57 USPQ2d at 1431-32;* italics in the original.

n30 *35 USC 291* reads as follows:

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

n31 *57 USPQ2d at 1433-34.*

n32 *57 USPQ2d at 1434.*

n33 *57 USPQ2d at 1434.*

n34 Notably, Snitzer didn't drop out of *Anderson v. Hill,* and Kanzaki was not about to abandon its Okada application in interference either.

n35 I have written this opinion up at much greater length in *The Majority of a Three-Judge Panel of the Federal Circuit Has Approved the Two-Way test of Winter v. Fujita--But Help May Be On the Way,* 10 Intellectual Property Today No. 9 at page 36 (2003).

n36 *334 F.3d at 1270, 67 USPQ2d at 1162.*

n37 *334 F.3d at 1273, 67 USPQ2d at 1167.*

n38 The opinions of both the majority and the dissent in the Federal Circuit are confused about what actually happened below. The majority states that "the Board...dismissed the interference," *334 F.3d at 1266, 67 USPQ2d at 1162,* and that Lilly took a particular action "after failing to instigate an interference...," *334 F.3d at 1266, 67 USPQ2d at 1162.* Similarly, the dissent states that "the Board of Patent Appeals and Interferences here declined to declare an interference between Lilly's reissue application and the University of Washington's patent...." *334 F.3d at 1272, 67 USPQ2d at 1167.* Actually, the panel of the Trial Section entered a *judgment* (that there was no interference-in-fact), and Eli Lilly *had* successfully instigated the interference (if the interference had not been "instigated"-- "declared" is the usual term for what happened--, there would have been no preliminary motions period).

n39 More accurately, it was the Trial Section's two-way test. However, under *In re Alappat, 33 F.3d 1526, 1531-36, 31 USPQ2d 1545, 1547-51 (Fed. Cir. 1994)* (in banc), the BPAI, including the Trial Section, is deemed to be a mere mouthpiece for the Director.

n40 *334 F.3d at 1267, 67 USPQ2d at 1163.*

n41 *334 F.3d at 1267, 67 USPQ2d at 1163.*

n42 *334 F.3d. at 1270, 67 USPQ2d at 1165.*

n43 *334 F.3d at 1269, 67 USPQ2d at 1165.*

n44 I believe that there are actually only two competing interpretations of 37 CFR 1.601(n)--the two-way test adopted by the Trial Section in *Winter* and the one-way test espoused by Eli Lilly--and many (probably most) members of the interference bar.

n45 *334 F.3d at 1269, 67 USPQ2d at 1165.*

n46 *334 F.3d at 1270, 67 USPQ2d at 1165-1166*

n47 *334 F.3d at 1273, 67 USPQ2d at 1168.*

n48 Of course, an interference *had been* declared, and Lilly *was* the senior party in that interference.

n49 *334 F.3d at 1273-74, 67 USPQ2d at 1168.*

n50 *334 F.3d at 1270, 67 USPQ2d at 1166.*

n51 *334 F.3d at 1273, 67 USPQ2d at 1167.*

n52 And wouldn't it be interesting if the different courts reached conflicting judgments! Of course, the Federal Circuit might ultimately sort things out--but at what a cost!

n53 In brief, interferences are an order of magnitude less expensive than district court infringement litigations because (a) they are tried to specialized judges who do not need to be educated concerning basic patent law and (b) juries are not involved. Accordingly, as noted by the dissent, the PTOBPAI would be "the optimal tribunal," *334 F.3d at 1274, 67 USPQ2d at 1168,* to decide the validity issue which the Trial Section and the majority ducked.

n54 *344 F.3d at 1339, 68 USPQ2d at 1474.* According to counsel for Dentlinger, that is *not* what the board held. According to counsel for Dentlinger, the board held that Dentlinger's re-direct *was* within the scope of Taskett's cross.

n55 37 CFR 1.671(b) reads as follows:

Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to interference proceedings. Those portions of the Federal Rules of Evidence relating to criminal actions, juries, and other matters not relevant to interferences shall not apply.

n56 FRE 611(b) reads as follows:

Scope of cross-examination. Cross-examination should be limited to the subject matter of the direct examination and matters affecting the credibility of the witness. The court may, in the exercise of discretion, permit inquiry into additional matters as if on direct examination.

n57 *344 F.3d at 1343, 68 USPQ2d at 1477.*

n58 See footnote 54, supra. According to counsel for Dentlinger, the panel (per APJ Urynowicz) did *not* so hold.

n59 *347 F.3d at 1308, 68 USPQ2d at 1711.*

n60 *347 F.3d 1308, 68 USPQ2d at 1711-12.*

n61 Judge Dr. Lourie refers to the technician as Dr. Wei, and Judge Dr. Newman refers to the technician as Ms. Wei.

n62 *347 F.3d at 1312-1313, 68 USPQ2d at 1715.*

n63 Judge Gajarsa's dissent was not based on the issue discussed here.

n64 The panel was apparently not a panel of the Trial Section. According to Judge Schall's opinion, "On June 30, 1998, the Examiner allowed claims 64-73 of the Velander application, but declared an interference between those claims and the issued Garner patent." *348 F.3d at 1362, 68 USPQ2d at 1770.* Of course, examiners cannot declare interferences. Interferences are declared by APJs. 37 CFR 1.610(a) ("Each interference will be declared by an Administrative Patent Judge...."). More importantly, the fact that this interference was declared prior to October 01, 1998, suggests (but does not prove) that it was not conducted by the Trial Section. Regrettably, it is the Federal Circuit's custom not to identify the administrative judges whose decisions they review.

n65 37 CFR 1.637(a) reads in relevant part as follows:

If a party files a motion for judgment under § 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party.

n66 *348 F.3d at 1365-1366, 68 USPQ2d at 1773-1774.*

n67 *348 F.3d at 1366, 68 USPQ2d at 1774.*

n68 *348 F.3d at 1367, 68 USPQ2d at 1775.*

n69 According to *35 USC 6,* "The administrative patent judges...[are] persons of competent legal knowledge and scientific ability...." However, there is nothing in the statute, the Code of Federal Regulations, or the Standard Operating Procedures of the BPAI that guarantees that any of the APJs assigned to a panel to decide a given interference are persons of ordinary skill, much less experts, in the field of the invention or inventions involved in that interference.

n70 *348 F.3d at 1374, 68 USPQ2d at 1780.*

n71 *348 F.3d at 1378-1379, 68 USPQ2d at 1784.*

n72 APJ Barrett is not in the Trial Section. This was one of the rare appearances of a non-Trial Section APJ on an opinion of the Trial Section.

n73 *67 USPQ2d at 1460;* italics omitted.

n74 *67 USPQ2d at 1461;* italics omitted.

n75 *67 USPQ2d at 1464.*

n76 *35 USC 135*(a) reads as follows:

Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

n77 *35 USC 291* reads as follows:

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

n78 One of the parties involved in the *35 USC 291* patent-patent interference had filed an application to re-issue its patent, thereby creating jurisdiction in the PTO. The District Court for the Southern District of New York decided that there was no interference-in-fact under *35 USC 291* between the claimed invention of Stampa's U.S. patent No. 6,084,100 and Jackson's U.S. Patent No. 6,093,827. Stampa appealed the decision. See *Medichem S.A. v. Rolabo S.L., 353 F.3d 928, 69 USPQ 1283 (Fed. Cir. 2003).* I have also commented on this opinion. See Section XIV.B. below.

n79 *65 USPQ2d at 1945.* Note that Judge Tierney stated that Stampa admitted that Jackson's claim 17, if prior art to Stampa, would make the subject matter defined by Stampa's claims 2 obvious. *65 USPQ2d at 1947.* However, according to the district court "the inclusion of tertiary amine in Medichem's [Stampa's] patent...[was] a material element of each of the claims of that patent and...the removal of tertiary amine in Rolabo's [Jackson's] patent...[would have been] significant but far from obvious in the prior art." *65 USPQ2d at 1943-44;* interpolations supplied by Judge Tierney.

n80 *65 USPQ2d at 1945.*

n81 The reason that he said that was not, as one might suspect, that the counts were different. According to Judge Tierney:

A count defines the interfering subject matter between the parties. The district court, having determined that there was no interfering subject matter, did not need to articulate a count. In contrast, the APJ has determined that there exists an interference-in-fact and declared this interference based upon Count I, a process according to claim 17 of U.S. Patent No. 6,093,827. The parties will be afforded an opportunity to file preliminary motions, including motions to redefine the interfering subject matter under 37 C.F.R. § 1.633(c). *[65 USPQ2d at 1948.]*

n82 *65 USPQ2d at 1945.*

n83 *65 USPQ2d at 1945.*

n84 *65 USPQ2d at 1947.*

n85 The "opinion of the Director" is an issue in an interference only implicitly. The substantive correctness of the Director's decision to declare an interference, presumably based on that opinion, is determined by the board in deciding motions to issue a judgment based on no interference in fact--i.e., the exact issue before the district court. In practice, the decision to declare an interference is made by an APJ, who is presumed to determine what would be (or is) "the opinion of the Director." That is, the "determination" of the Director is a pure legal fiction. In any event, the Director has (and his predecessors, the Commissioners, have) never been called upon to testify concerning their opinions regarding issues of interference-in-fact.

Judge Tierney's own analysis of the interfering claims states that "Both processes involve reacting a dibenzob-suberone with an aliphatic ketone, such as ethyl 4-oxopiperidine-1- carboxylate." *65 USPQ2d at 1946.* However, the latter compound is a heterocyclic ketone, not an aliphatic ketone. See *In re Cavallito, 306 F.2d 505, 510, 134 USPQ 370, 374 (CCPA 1962),* for definitions of "aliphatic." Thus, Stampa's reactant ketone is not simply a typical member of Jackson's class of "aliphatic ketones."

Apparently the characterization of ethyl 4-oxopiperidine-1-1 carboxylate as an aliphatic ketone, while erroneous, was present in Jackson's specification as filed. Moreover, according to counsel for Stampa, the actual reactants disclosed in Jackson's patent and in Stampa's application are identical, so the mischaracterization of the genus is irrelevant. Compare *Lee v. McIntyre, 55 USPQ2d 1406, 1409-10 (PTOBPAI 2000)* (expanded panel), where a panel of the board "construed" claims that were apparently not intended to mean what they said "in light of the specification" and dependent claims to make them mean what the SAPJ thought that they should have said. See Gholz, *A Critique of Recent Opinions in Patent Interferences, 83 JPTOS 161, 185-86 (2001).* But also compare *In re Barr, 444 F.2d 588, 597, 170 USPQ 330, 338-39 (CCPA 1971)* (Rich, J.) (dependent claim inconsistent with base claim held to be indefinite.); and *In re Hill, 161 F.2d 367, 368-69, 73 USPQ 482, 484 (CCPA 1947)* ("While it is trite, as is contended here, to say that a patent specification may explain the language of the claim, it is incorrect, as pointed out by the solicitor in his brief, to say '*** the specification may distort a term to mean something it does not mean'.").

n86 See Gholz, *A Critique of Recent Opinions in Patent Interferences, 85 JPTOS 401 (2003)* (in press), at section X.A., "Interfering Claims in Patent-Patent Interferences."

n87 *353 F.3d at 935-36, 69 USPQ2d at 1288-89.*

n88 See section XIV.A regarding my comments on *Stampa v. Jackson.*

n89 *353 F.3d at 936, 69 USPQ2d at 1289.*

n90 *353 F.3d at 936, 69 USPQ2d at 1289.*

n91 *Id.*

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not w/p	not in same paragrap
w/seg	in same segment
not w/seg	not in same segment
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not w/N	not within N words
pre /N	precedes by N words
w/p	in same paragraph
not w/p	not in same paragraph
w/seg	in same segment
not w/seg	not in same segment
w/s	in same sentence
not w/s	not in same sentence
and not	and not

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